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OCT 24 2007
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(LHTLG No. 00,464-A)

In re Application of:

Brown

Serial No. **09/876,408**

Filed: **June 7, 2001**

For: **METHOD AND SYSTEM FOR PROTECTING DOMAIN NAMES**

Examiner: **Nguyen, Tan D.**

Group Art Unit: **3629**

Confirmation No. **7316**

MAIL STOP: Appeal
Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

TRANSMITTAL LETTER

1. We are transmitting herewith the attached papers for the above identified patent application:

☒ **AMENDED PATENT APPEAL BRIEF under 37 C.F.R. §1.192 (60 pages).**
☒ **Exhibits A-F for Patent Appeal Brief (Appendix B) (84 pages).**
☒ **Response to Non-Compliant Appeal Brief – Mailed Sept. 25, 2007 (2 pages).**
☒ **Return Postcard.**

2. **FEES:** No fees are required.

3. **GENERAL AUTHORIZATION TO CHARGE OR CREDIT FEES:** No fees or extensions of time are required. Should this assumption be incorrect, if an extension of time is required, consider this a petition and request therefor under 37 CFR § 1.136 and charge any additional fees (or credit overpayment) to Deposit Account No. **50-2281** for **Lesavich High-Tech Law Group, PC (32097).**

4. **CERTIFICATE OF MAILING under 37 CFR § 1.10**, the correspondence identified above was deposited with the United States Postal Service as "Express Mail Post Office to Addressee," addressed to the Mail Stop: Appeal, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on the **24th** Day of **October 2007.** Express Mail Number **EV957084121US.**

EV957084121US

Respectfully submitted,

Lesavich High-Tech Law Group, P.C. (32097)

Date: October 24, 2007

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RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF
Mailed Sept. 25, 2007
(37 CFR 41.37)

In response to the Notification of Non-Compliant Appeal Brief mailed September 25, 2007, the Applicant submits herewith an amended appeal brief. A response was due within one month or by **October 25, 2007**.

The amended appeal brief includes: (1) the required headings under 37 CFR 41.37; (2) a summary of the claimed subject matter that identifies and maps all independent claims on appeal (1, 14, 19, 25, 30 & 32) to the specification and drawings; (3) re-ordering of the grounds of rejection to comply with order of the rejections listed by the Examiner in the Final Office Action; (4) changed headings of arguments so arguments argue each ground of rejection under their own headings;

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(5) included the word NONE in the Related Proceedings Appendix; and (6) removed improper headings.

All of these changes are requested by Tracey Young, Patent Appeal Center Specialist. The Applicant submits that the Applicant has corrected all alleged defects and the amended appeal brief is now compliant with 37 CFR 41.37, as the Applicant understands it.

Respectfully submitted,

Lesavich High-Tech Law Group, P.C. (32097)

Date: October 24, 2007

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Board of Patent Appeals and Interferences
(LHTLG No. 00,464-A)

In re Application of:	)	
	)	Examiner: **Nguyen, Tan, D.**
Brown	)	
	)	Group Art Unit: **3629**
Serial No. **09/876,408**	)	
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PATENT APPEAL BRIEF

37 C.F.R. §1.192

Stephen Lesavich, PhD

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BRIEF OF APPELLANT

This is a Patent Appeal Brief submitted under 37 C.F.R. § 1.192 to the Board of Patent Appeals and Interferences from the third rejection of all of the claims of the application. This Appeal Brief is accompanied by the requisite fee set forth in 37 C.F.R. § 41.20(b)(2) for a small entity under 37 C.F.R. § 1.27(a). The Notice of Appeal under 37 C.F.R. § 1.191 was filed on August 20, 2007.

This Appeal Brief is also a response to the assertions the Examiner made in the Final Office Action mailed May 18, 2007. The Appellant traverses all of the Examiner's assertions in this Final Office Action. The Appellant may respond to selected assertions by the Examiner, but the Appellant intends to traverse all of the Examiner's assertions in the Final Office Action.

REAL PARTY IN INTEREST

The Appellant, Charles P. Brown, is the real-party in interest.

RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences known to the Appellant.

STATUS OF CLAIMS

The status of the claims is as follows:

1. Claims at filing: 1-33
2. No Claims have been amended.
3. Claims pending: 1-33.
4. Claims rejected: 1-33.
5. Claims allowed: None.

Thus, the claims on appeal are claims 1-33.

STATUS OF AMENDMENTS

No amendments have been filed in the application and no amendments have been entered as understood by the Appellant.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The numbers in the following text in parenthesis have been added by the Appellant. The numbers without parenthesis appeared in the original application text. The Appellant also includes paragraph numbers from the corresponding U.S. published patent application 2002/0010795 (designated as Pub. [xxxx]) included as **Exhibit F** for easy reference by the Board.

A method and system for protecting domain names. A permanent registration certificate for providing a permanent registration of a domain name is issued (FIG. 1, 26). The permanent registration certificate provides a permanent registration of a domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar (28). A permanent web-site (24) accessible via the Internet (18) and associated with a domain name registration from an issued permanent registration certificate is perpetually hosted. The method and system help prevent a domain name owner from ever losing valuable domain name rights, reduce the burden and administrative overhead placed on domain name owners and more fully utilize existing and new rights associated with a domain name registration. ***(Application, Abstract, page 48, Pub., page 1).***

Plural server network devices 20, 22, 24 (FIG. 1) are associated with one or more associated databases are components of a permanent domain name registration system 26. The permanent domain name registration system 26 includes a Purchase/Payment server 20, an Administrative server 22 and a Web-site hosting server 24. The plural network devices 20, 22 and 24 provide system for allowing a "permanent registration" of a domain name. ***(Application, page 11, lines 14-19, Pub. [0036]).***

The Purchase/Payment server 20 accepts domain name registration information and handles payment of current and future renewal fees for a domain

name. The administrative server 22 helps ensures that the payment has been received by the public domain name registrar by checking for the updated next payment date, verifying payments, determining and solving payment and information discrepancies, etc. The Web-site hosting server 24 allows a domain name for which a permanent registration has been obtained to have a permanent presence on the computer network 18. Thus, the Web-site hosting server 24 can "permanently" host a web-site. ***(Application, page 12, lines 10-17, Pub. [0036-0039]).***

Claim 1

FIG. 2 is a flow diagram illustrating a Method 30 for protecting domain name registrations with a permanent registration certificate. At Step 32, information associated with a domain name registration obtained from a public domain name registrar (FIG. 1 28) is accepted on a permanent domain name registration system (26). At Step 34, a one-time permanent registration fee for the domain name registration is accepted on the permanent domain name registration system (26). At Step 36, a permanent registration certificate is issued for the domain name registration based on the accepted information. The permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying future renewal fees for the domain name registration at the public domain name registrar (28) from the permanent domain name registration system (26).

Method 30 may also comprise any or all of the additional steps of: issuing a domain name registration title, issuing an insurance policy, issuing plural ownership shares, issuing leases or sub-leases, issuing co-ownership certificates, or creating new or additional rights in the domain name associated with the permanent registration certificate. ***(Application, page 13 line 20 through Page 14, line 11, Pub. [0044-0045], FIGS. 1 and 4).***

In one embodiment of the present invention, the one-time permanent registration fee is added to financial instruments whose profits or interest is used to perpetually pay future renewal fees for the domain name registration. For example, the financial instrument can include an interest bearing account, a certificate of

deposit, mutual funds, stocks, bonds, annuities, or other type of financial instrument. ***(Application, page 13 line 20 through Page 14, line 11, Pub. [0060]).***

The one-time permanent registration fee is selected such that a first portion of the fee will be used to satisfy current registration fees and administrative costs at the public domain name registrar 28. A second portion of the fee is enough to generate interest or other income through investments and/or the sale of additional goods or services to pay all current and future administrative costs and future registration fees in perpetuity for the domain name registration on the permanent domain name registration system 26. One skilled in the art can determine that the one-time permanent registration fee can be divided into various other portions that are distributed in various ways to cover costs and fees on the permanent domain name registration system 26 and the public domain name registrar 28. ***(Application, page 18, lines 11-20, Pub. [0061]).***

Claim 14

FIG. 4 is a block diagram illustrating an exemplary data flow 54 associated with Method 40 of FIG. 3. In FIG. 3A at Step 42, a list of domain name registrations 56 is generated by the Purchase/Payment Server 20 from one or more databases 20', 22' and 24' associated with a permanent domain name registration system 26 for which renewal fees on a public domain name registrar 28 must be paid. This is illustrated by Line 58.

At Step 44, renewals fees are paid electronically to an account 60 for the public domain name registrar 28 for the list of generated domain name registrations 56. This is illustrated by Line 62.

At Step 46, a query is conducted from the Administrative Server 28 at the public domain register 28 to determine whether all of the domain name registrations from the generated list of domain name registrations 56 have been renewed on the public domain name registrar 28. This is illustrated by Line 64.

If there are any domain names from the list that have not be marked as renewed by the public domain name registrar 28, the Administrative server 22 flags any such domain names. The Administrative server 22 sends a message to the

Purchase/Payment server 20 to transfer the additional funds to the public domain name registrar 28. This is illustrated by Line 66.

At Step 48 of FIG. 3B, additional renewal fees are transferred by the Purchase/Payment server 20 for any domain name registrations that have not been renewed on the public domain name registrar 28, thereby ensuring renewal of domain name registrations. This is illustrated by Line 68. At Step 50, the Administrative server 22 notifies the Purchase/Payment Server 22 at the permanent domain name registration system 26 and the public domain name registrar server 28 of any renewal fee discrepancies. This is illustrated by lines 70 and 70'. ***(Application, page 28, line 7 through page 29, line 7, Pub. [0096]-[0100], FIGS. 1 and 4)***

Claim 19

FIG. 5 is a flow diagram illustrating a Method 74 for providing a permanent web-site. At Step 76, a domain name for which a permanent registration certificate has been issued is accepted on a permanent domain name registration system (26). The permanent registration certificate provides a permanent registration of the domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar (28) from the permanent domain name registration system (26). At Step 78, electronic content for a web-site to be associated with the domain name is accepted (18, 24). At Step 80, a one-time permanent web-site fee for hosting the domain name on the permanent domain name registration system(26) is accepted. The one-time permanent web-site fee is used to perpetually host the domain name on the permanent domain name registration system. At Step 82, a web-site (24) accessible via the Internet (18) associated with the domain name is perpetually hosted (24) on the permanent domain name system (26). **(Application, page 29, lines 9-21, Pub. [0102]-[0013], FIGS. 1 and 4).**

Claim 25

FIG. 6 is a flow diagram illustrating a Method 86 for providing a co-use of a permanent domain name. At Step 88, a permanent domain name is hosted on a network server(20, 22, 24). The permanent domain name is a domain name for which a permanent registration certificate has been issued. The permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at a public domain name registrar from a permanent domain name registration system. The permanent domain name is co-used by plural co-user s(e.g., 12, 14, 16). At Step 90, a request for electronic content is accepted on the network server (20, 22, 24) for one of the plural co-users using the permanent domain name. At Step 92, a determination is made to determine which one of the plural co-users the request is for using information included in headers used with a protocol used to request the electronic content. At Step 94, the request is directed to the determined co-user.

The plural co-users can be co-owners of the permanent domain name. The plural co-users can also be leasing or sub-leasing the permanent domain name for one or more permanent domain name owners. Co-ownership and leasing/sub-leasing of a permanent domain name was discussed above. ***(Application, page 29, through Page 35, line 5, Pub. [0115]-[0122], FIGS. 1 and 4).***

Claim 30

Permanent Registration Certificate:

(FIG. 1, FIG. 4)
(Application, page 13 line 20 through Page 14, line 11, Pub. [0044-0045]).
(Application, page 18, lines 11-20, Pub. [0061]).
(Application page 20, line 13 through page 21, line 9, [0044]-[0067], Table 1).
(Application, page 29, lines 9-21, Pub. [0102]-[0113]).
(Application, page 29, through Page 35, line 5, Pub. [0115]-[0122].

Plural servers (20, 22, 24) for providing and managing Permanent Registration Certificates:

(Application, page 11, lines 14-19 through page 12, lines 10-17, Pub. [0036-0039]).

(Application page 20, line 13 through page 21, line 9, [0044]-[0067], Table 1).

Claim 32

Permanent Registration Certificate:

(FIG. 1, FIG. 4)
(Application, page 13 line 20 through Page 14, line 11, Pub. [0044-0045]).
(Application, page 18, lines 11-20, Pub. [0061]).
(Application page 20, line 13 through page 21, line 9, [0044]-[0067], Table 1).
(Application, page 29, lines 9-21, Pub. [0102]-[0113]).
(Application, page 29, through Page 35, line 5, Pub. [0115]-[0122].

Permanent Web-site:

(FIG. 1, FIG. 4)
(Application, page 11, lines 14-19 through page 12, lines 10-17, Pub. [0036-0039]).

(Application, page 29, lines 9-21, Pub. [0102]-[0113]).

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether Examiner Nguyen incorrectly applied U.S. Patent Law numerous times and is treating the Appellant unfairly by not considering the Appellant arguments in his RESPONSE TO ARGUMENTS assertions in the Final Office Action and his corresponding assertions in the First and Second Office Actions.

2. Whether Examiner Nguyen correctly applied 35 U.S.C. §112, ¶2 rejection to reject claims 1-13 and 19-24 with an assertion that a claim element is vague and indefinite, the same claim element the Examiner had previously admitted included patentable feature.

3. Whether Examiner Nguyen correctly applied 35 U.S.C. 103(a) and rejected Claims 1-3, 12-13, 14-18, 19-20, 23-24, 25-29, 30-31 and 32-33 as being unpatentable under 35 U.S.C. §103(a) over alleged Applicant Admitted Prior Art (AAPA), that is over the Appellant's patent application itself,in view of Koritzinsky (U.S. Patent No. 6,272,469).

4. Whether Examiner Nguyen correctly applied 35 U.S.C. 103(a) and rejected claims 4-5 as being unpatentable over alleged Applicant Admitted Prior Art (AAPA), that is over the Appellant's patent application itself, in view of Loritzinsky (U.S. Patent No. 6,272,469) and further in view of Mann et al. (U.S. Patent No. 6,519,589) and further in view of Cummings et al. (U.S. Patent No. 6,470,321).

5. Whether Examiner Nguyen correctly applied 35 U.S.C. 103(a) and rejected claims 6-8, 10-11 and 21-22 as being unpatentable over alleged Applicant Admitted Prior Art, that is over the Appellant's patent application itself, in view of Loritzinsky (U.S. Patent No. 6,272,469) and further in view of Burstein et al. (U.S. Patent No. 7,076,541).

ARGUMENT

ARGUMENT FOR REJECTION 1

INDEPENDENT CLAIMS 1, 14, 19, 25, 30, 32:

The Appellant repeats its traverse of all the assertions made by the Examiner in the First Office Action, Second Office Action and Third Final Office Action.

In a First Office Action (page 2) the Examiner rejected all of the claims of the application under 35 U.S.C. 101. The Examiner asserted that "The U.S. department of commerce, working under the authority of Congress, is under contract with ICANN for the domain name registration, and therefore has no authority to grant a patent to a system that they have no jurisdiction over. Claims 1-33 are rejected on ground that they infringe on U.S. laws set forth by Congress."

This is a first instance of the Examiner's improper application of U.S. Patent laws and lack of understanding of the domain name registration system and the Appellant's claimed invention.

In a First Response (pages, 2-5) the Appellant traversed this 101 rejection and conducted a simple patent search and determined that the United States Patent and Trademark Office (USPTO) has issued at least seven patents that include the terms "domain name registration" in the claims. In addition, there were 25 pending USPTO published patent applications what include the terms "domain name registration" in their claims.

The Examiner could have easily conducted such a search himself. In addition, one of the issued patents, Mann (U.S. Patent No. 6,519,589), cited by the Examiner for a 103 rejection used to reject the claims included an invention including a system for generating the text for domain name and for facilitating its registration with a public domain name registrar. The Appellant argued that if trying to patent inventions related to domain name registrations really did infringe on laws set by Congress the U.S. Patent Office would not have granted any such patents or accepted and published so many additional patent applications related to the same topic.

In a Second Office Action (page 2) the Examiner withdrew this nonsensical 101 rejection.

In the First Office Action (page 3) the Examiner also rejected Claims 1-13 and 19-34 under 35 U.S.C. 103(a) as being unpatentable over alleged *Applicant Admitted Prior Art (AAPA)* in view of *Mann* (U.S. Patent No. 6,519,589) in view of *Koritzinsky* (U.S. Patent No. 6,272,469) in view of *Hagan* (U.S. Patent No. 6,415,267).

The Examiner asserted "As for claim 1 Applicant Admitted Prior Art (AAPA) fairly discloses the method of registration is well known. " (First Office Action, page 4, paragraph 1). In other words, the Examine asserted he was rejecting the Appellant's invention in Claim 1 over the invention disclosed in the Appellant's own application. This is a second instance of the Examiner's improper application of U.S. Patent laws and lack of understanding of the domain name registration system and the Appellant's claimed invention.

The Applicant traversed this rejection submitted that there was no AAPA as alleged by the Examiner and provided eight (8) pages of arguments as to why the claimed invention was not obvious (First Response, pages 5-13).

In the Second Office Action (page 2, paragraph 1) The Examiner then asserted the Applicant's 103 response arguments were "not persuasive."

However, after reading the Appellant's response to the assertions, the Examiner apparently withdraw with the First 103 Rejection without explanation created a brand new Second 103 Rejection.

In the Second 103 Rejection he rejected Claims 1-3, 9, 12-13, 14-18, 19-20, 23-24, 25-29 30-31 and 32-33 under 35 U.S.C. 103(a) as being unpatentable of alleged AAPA in view of Koritzinsky (U.S. Patent No. 6,272,469). (Second Office Action, page 3, paragraph 5).

The Board will note that for this second 103 rejection, the Examiner dropped *Mann* and *Hagan* from the rejection, even though the Appellant's arguments were "deemed unpersuasive."

This is a third instance of the Examiner's improper application of U.S. Patent laws and his lack of understanding the domain name registration system and the Appellant's claimed invention.

With respect to Claim 1, the Examiner then asserted the Appellant's own application is "alleged APPA" and teaches all of the claimed inventions in the Background of the Invention in the specification specifically on page 3 in the last two paragraphs, page 3, lines 19-21 and page 4, last paragraph. (Second Office Action, page 5). *This is simply not true.* All the Appellant did in the Background section of

the application was to describe some background information and list some problems associated with domain names.

Claim 1 teaches:

1. A method for protecting domain name registrations with a permanent registration certificate, comprising:

accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;

accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; and

issuing a permanent registration certificate for the domain name registration based on the accepted information, wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

Lines 19-21 and last two paragraphs and of page 3 of the Appellant's application teach:

Another problem is that the current system of Internet domain ownership does not confer ownership in the traditional sense of the word. What is now referred to as "domain name ownership" is really just a right to use a domain, provided that the registration fee is current. An entity that "owns" a domain name retains the right to use that domain name by paying the registration fee on time. Otherwise the usage rights to the domain name are forfeited and the domain name returns to the general pool of domain names available for anyone to register and acquire usage rights.

Network Solutions, Inc. ("NSI") under contract with the National Science Foundation was the exclusive registrar of TLD's from 1993-1998. The Internet Corporation for Assigned Names and Numbers ("ICANN") was established in 1998 to move the administration of the DNS to the private sector. There are now many different approved organizations that can register domain names in association with ICANN. For example, a domain name can be registered electronically at nsi.com, register.com, namedroppers.com, domainnameregistration.com, budgetregister.com and other web-sites on the Internet.

There are a number of problems associated with the current system of registering domain names. One problem is that the current system of registration fees for Global TLDs is designed to ensure that there is money available each year from each domain to contribute to the support of the registry/registrar system and the DNS. To achieve the purpose of ensuring funding and that each domain contributes to the system each year. This system establishes a monetary self-sufficiency for the registration system, but at the cost of administrative overhead and business risk for the users of the system.

The last paragraph of page 4 of the Appellant's application teaches:

Another problem is that domain names have become valuable entities unto themselves, far out of proportion in value to the cost of an annual registration fee. Some domains have a commercial value of millions of dollars, but non-payment of a single $35 payment can result in the loss of valuable rights and will disconnect a web-site at a domain name address.

The Board can clearly see that none of the claim elements are recited in this section of the Appellant's application as asserted by the Examiner. These sections cited by the Examiner do not include any reference to the permanent domain name registration system and permanent website hosting system claimed by the Appellant.

Thus, these cited paragraphs and nothing else in the Background section of the Appellant's application are certainly NOT the alleged AAPA as applied to the claimed invention. None of these sections teach or suggest any feature at all related to the permanent domain name registration system recited by the other claim elements. This is clearly a serious error in the application of U.S. Patent law by the Examiner.

The Examiner then did something that the Appellant has never seen before in his whole career as a patent attorney. The Examiner wrote his own claim with his own words which he extracted from the prior art reference Koritzinsky (Second

Office Action, page 4) to provide a basis for his 103 rejection where none actually exits.

The Board certainly understands that the role of the Examiner under MPEP §706 is to examine the claims of patent applications written by applicants' and not to draft claims for the applicant and not to draft claims and assert them over an applicant's claims.

The Board is requested to review Table 1 including Claim 1 as filed by the Appellant and the contrived claim crafted by the Examiner to support his rejections using words he extracted from Koritzinsky.

Claim as filed by Appellant	CLAIM 1 written by the Examiner:
1. A method for protecting domain name registrations with a permanent registration certificate, comprising:	1. A method for protecting a subscription service with a permanent service certificate, wherein the service is domain name registrations subscriptions, comprising:
accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;	accepting information associated with a subscription service, wherein the subscription service is domain name registration obtained from a public domain registrar on a domain name registration system;
accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; and	accepting a one-time permanent registration fee for the subscription service wherein the subscription service is domain name registration, on a permanent subscription service system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the subscription service; and
issuing a permanent registration certificate for the domain name registration based on the accepted information, wherein the permanent	issuing a permanent service certificate based on the accepted information, wherein the subscription service is domain name registration, and the

registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.	permanent service certificate is about domain name registration the certificate provides a permanent registration the domain name registration including perpetually determining paying and verifying current and future renewal fees due for a domain name registration at the public domain name registrar from the permanent domain name registration system.

Table 1.

As ridiculous as this exercise is, the Examiner then, in a totally self-serving manner asserts that the new claim he wrote with the own words extracted from Koritzinsky *reads over* Appellant's invention recited by Claim 1. (Second Office Action, page 4). Thus, the Examiner asserts the Appellant's invention is obvious over the combination over the alleged AAPA (which as is explained above is NOT true) and Koritzinsky.

What the Board can easily see is that the Examiner is trying to add features to the Appellant's claimed invention that are not necessary to practice the Appellant's invention. The Appellant's invention has no need for the features added to the Appellant's claim by the Examiner. The Appellant's invention already includes claim new, novel and non-obvious elements for a permanent domain registration system and permanent website hosting system and has no need for the elements added by the Examiner from Koritznsky that related to paying fees for a subscription to medical imaging systems.

In addition, so what. If this claim written by the Examiner reads over the Appellant's claim, which it clearly does not, the claim was written by the Examiner. The claim was not written by the Appellant. It was not written Koritzinsky. It does

not appear in any prior art reference. It was written by the Examiner in violation of patent rules. A very interesting new tool for Examiners to use. Write their own claims and assert their own claims read over those filed by an applicant.

Further, the Board will note that all words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). The Examiner has not considered all words in the claims drafted by the Appellant. Instead the Examiner has drafted his own claim and is considering his own words to artificially support his own rejections.

This is a fourth instance of the Examiner's improper application of U.S. Patent laws and his lack of understanding of the domain name registration system and the Appellant's claimed invention.

Based on the improper self-serving analysis the Examiner then asserted the Appellant admitted all of the elements of Claim 1 alleged AAPA (NOT true as discussed above) except for one.

The Examiner then concedes that the Appellant's alleged AAPA did not teach or suggest the second element of Claim 1: *accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration.*

The Board will also note that if the alleged AAPA did not teach this claim element it could not have taught the other elements of Appellant's Claim 1 because the other elements include the claim limitations of a *permanent domain name registration system.*

The Examiner further asserted the whole invention was taught "except for the type of fee payment for subscription (registration) service from annual payment ($35.00/year) to a one-time permanent registration fee with would result in an issuing of a permanent registration certificate, for example a payment of $3,500 to cover 100 years or a $1,000,000 for perpetually permanent service."

The statement also illustrates how the Examiner does not really understand the Appellant's claimed invention. The last paragraph of page 4 of the Appellant's application cited above states annual domain name registration fees are $35 and are paid to a public domain registrar and that selected domain names have a commercial value of millions of dollars, not someone paying millions of dollars to renew domain names in a single payment as no one could or would attempt to do.

The Appellant's invention in part teaches a one-time permanent registration fee payment to perpetually pay all future renewal fees for the domain name registration and/or web-site hosting. A current payment actually charge by the Appellant's for use of the claimed invention is hundreds of dollars (e.g., $995, etc.). A portion of the few hundred dollars is used to pay domain name registration and website hosting renewal fees in the short term. The remaining portion of the permanent registration fee is invested and the investment income to used to pay renewal fees for the long term.

As a practical matter, no one would submit $1,000,000 as the Examiner suggests because no rational person would use such a large some of money to renew domain names and such a large fee is not necessary to practice the claimed invention. However, even if a $1,000,000 fee were paid to a public domain register, it would NOT provide the permanent domain name and website hosting system as

claimed by the Appellant. When the $1,000,000 fee is exhausted, the domain name registration would require someone pay additional funds to maintain it.

The Appellant in part, has an actual business for providing a permanent memorial web-site for deceased people and pets that provides an "electronic tombstone" on the Internet for perpetuity based on the claimed invention.

However, Examiner then asserts for the first time in the Second Office Action that the claim element "accepting a one-time permanent registration fee," the very claim element he considered to be novel, is also now vague and indefinite and rejected Claim 1 (as well as claims 1-13 and 19-24) with a 35 U.S.C. §112, ¶2 rejection. This is the only claim element of Claim 1 (and Claim 19) that the Examiner admitted was a new unique, novel and nonobvious feature.

The Board will note the Examiner did not raise this rejection in the First Office Action. The Examiner, appears to requiring the Appellant to modify one of the Appellant's claim element of Claim 1 and 19 that to fit into the Examiner's 103 rejection scheme, the Examiner's own claim and for alleged AAPA in view of Koritzinsky to strengthen the Examiner's ability to maintain his improper rejections. Something really stinks here.

The Examiner also asserts Koritzinsky teaches a subscription service with various types of payments for medical image systems is the same as the Appellant's invention for domain name registrations, *even though Koritzinsky does not teach, suggest or even mention domain names or registrations of domain names, period.* The Examiner then, to further bolster his position, decides *sua sponte* that "the type of subscription service is not critical since fee payment arrangements can be applied in any subscription service." The Examiner further asserts that "as for the difference

in the type of subscription service, again, this is not critical and within the skill of the artisian." (Second Office Action, page 6). Thus, the Examiner has come full circle in his circular logic and has concluded that any fee payment system makes the Appellant's claim permanent domain name registration system obvious because a claim element the Examiner deemed patentable is really not critical all to anything. The Examiner also decides only what he thinks is "critical" without any proof or basis under the patent rules or fact.

In the Second Office Action, a second non-final rejection, the Examiner also did a new search and created new 103 rejections with new references including Cummings and Burstein (Second Office Action, pages 8-9). A new search was not appropriate or necessary since the Applicant did not amend the claims and the Examiner withdraw a least a portion of his 103 rejections even though he stated the Appellant's arguments were "unpersuasive."

These actions by the Examiner violated MPEP rule 706.07. MPEP Rules 706.07 clearly states:

> *To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; Switching from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.*

The Examiner did not allow any claims or finally reject any claims in this second non-final office action.

In a Third Final Office Action (page 11) the Examiner also complains that he sent two previous office actions for and the Final office action with the same assertions and the Appellant did amend any of the claims.

The Examiner then the audacity now to assert that the Appellant's arguments in the previous two responses "***fail to comply with 37 C.F.R. 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out the how the language of the claims patentably distinguishes them from the references.***" (Third Final Office Action, page 10, paragraph 12).

This assertion also shows the Examiner is clearly biased toward the Appellant and is not fairly considering the Appellant's arguments and has not considered the Appellant's arguments at all.

The Board is now urged to turn to the Exhibits and review the First and Second Responses filed by the Appellant.

The Appellant submitted a First Response that was 19 pages long that clearly, concisely and explicitly how the claims were patentably distinct from the references cited by the Examiner based on current case law and the patent rules. The Appellant submitted a Second Response that was 15 pages long that clearly, concisely and explicitly how the claims were patentably distinct from the references cited by the Examiner based on current case law and the patent rules. The Appellant has submitted a total of 34 pages of well reasoned legal arguments yet the Examiner still asserts the Appellant has not specifically pointed out how the language of the claims patentably distinguishes the claims from the cited references.

Also, the Examiner withdraw his rejections to *Mann* and *Hagen* and then makes such a biased assertion.

In addition, three office actions with incorrect application of U.S. Patent Law are just that: three bad office actions with incorrect application of U.S. Patent Law. The Appellant can only respond in a very limited number of ways to a clear misapplication of U.S. Patent Laws.

The Board must correct the Examiner's misapplication of U.S. Patent Law and unfair treatment of the Appellant and must not allow such mistakes and behavior to continue.

CONCLUSION FOR REJECTION 1

Based on these remarks, the Appellant now requests the Appeal Board instruct the Examiner to immediately withdraw all rejections and immediately pass all the claims to allowance. In the alternative, if the Board feels the claims are not ready for allowance the Appellant requests the application be passed to another Examiner who will at least treat the Appellant fairly.

ARGUMENT FOR REJECTION 2

The Examiner rejects claims 1-13 and 19-24 under 35 U.S.C. §112, 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 5, the 2nd step of 'accepting a one-time permanent registration fee' *is vague and indefinite.* From the specification, it appears this phrase appears to mean "accepting a one-time permanent registration fee payment" and therefore, insertion of the term "payment" after "fee" is recommended to improve clarity. Similarly, claims 19-24, are rejected for the same reasons set forth in claims 1-13 above." The Appellant traverses this rejection.

All of the Arguments for Issues 1 and 3 are incorporated herein by reference. The Board will note that the Examiner has rejected a portion of the Appellant's claim that the Examiner admitted was not taught by any of the cited or alleged prior art as now being vague and indefinite.

The test for definiteness under 35 U.S.C. 112, second paragraph, is whether "*those skilled in the art would understand what is claimed when the claim is read in light of the specification.*" *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, (Fed. Cir. 1986).

The cited portions of Claims 1 and 19 clearly meet this test for definiteness under the holding of *Orthokinetics, Inc.* The Examiner's own words support the Appellant has met the burden of this test.

In addition, the Board will note Examiner by his own words clearly violated the patent rule cited forth in MPEP §2173.02. This rule states "that if the language

used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the Examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the Examiner should suggest improved language to the applicant...*If the applicant does not accept the Examiner's suggestion, the Examiner should not pursue the issue.*" MPEP §2173.02

CONCLUSION FOR REJECTION 2

Thus, the 35 U.S.C. 112, second paragraph is clearly improper. Therefore, the Appellant now requests the Appeal Board instruct the Examiner to immediately withdraw the 35 U.S.C. 112, second paragraph with respect to the cited claims.

ARGUMENT FOR REJECTION 3

The Examiner has rejected Claims 1-3, 12-13, 14-18, 19-20, 23-24, 25-29, 30-31 and 32-33 as being unpatentable under 35 U.S.C. §103(a) over alleged Applicant Admitted Prior Art (AAPA) in view of Koritzinsky (U.S. Patent No. 6,272,469).

INDEPENDENT CLAIMS 1, 14, 19, 25, 30, 32:

The Appellant repeats its traverse of all the assertions made by the Examiner in the First Office Action, Second Office Action and Third Final Office Action.

As was discussed in detail above, the Appellant did not admit any of the claim elements of the claimed invention in the Background section of the application. All the Appellant did was provide a general background discussion. There is no AAPA that describes the claimed invention. Period. Enough said. As a result, the 103 rejection is improper on it face since Koritzinsky does not teach suggest or even mention domain names. Thus, the Examiner has clearly not provided a prima facie basis for obviousness under 35 U.S.C. §103(a)

Thus, the Appellant really need not respond any further. However, the Appellant responds as follows to point out all the remaining errors in the Examiner's assertions for the Board.

To establish a *prima facie* case of obviousness in the first place, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary

skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

I. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

There are three possible sources for a motivation to combine references: (1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art. *In re Rouffet,* 149 F.3d 1350, 1357 (Fed. Cir. 1998).

a. The nature of the problem to be solved: The problem in general, solved by the Appellant's invention was to provide a way for a person to pay a small amount of money to provide a permanent domain name registration and/or permanent web-site hosting. The small amount of money would be invested and investment income would be used to pay renewal fees in perpetuity. The claimed invention helps ensure that an important domain name would not be lost for failure to pay renewal fees. The claimed invention also provides a way for a person to provide a perpetual electronic memorial on the Internet for a deceased relative or pet.

The Examiner cites the Background section of the Appellant's patent application as teaching the claimed invention. The Examiner specifically cited page

3, lines 19-21, page 3, last two paragraphs and pages 4-6 of the Appellant's application. As was discussed above and illustrated by the exact sections the Examiner cited, the Appellant did NOT admit the invention in the Background section. The Appellant did nothing more than describe the nature of the problem to be solved and provide general information about how a domain name is registered.

The Examiner cited no other prior art period other than the Appellant's own patent application that discussed the solution the problem solved by the Appellant's invention, namely, a permanent domain name registration and/or website hosting system.

The Examiner then seeks to combine the Appellant's own patent application with Koritzinksky which teaches medical diagnostic and imaging systems which are configured to execute protocols for examinations, image acquisition, and so forth. More particularly, the invention relates to a technique for making such protocols available to a system user, for easily selecting such protocols and installing them for use, and for transmitting protocols to diagnostic systems where they can be executed. (Col. 1, lines 5-12).

The Examiner asserts that since the Appellant has allegedly admitted the claimed invention in the Background section of the application (which is simply NOT true) and Koritzinsky teaches at (col. 21, lines 15-50) a subscription service for the medical diagnostic systems that allows pay-per-use and yearly fees for a license the combination of the two has solved the problem of providing a permanent domain name registration system.

Koritzinsky does not teach, suggest or even mention domain names or domain name registrations, anywhere, period. Koritzinsky teaches or suggests nothing that

can be used to solve the problems the Appellant has solved with the claimed inventions.

Combining the Appellant's own application with Koritzinsky is clearly an erroneous assertion by the Examiner in violation of the first prong of *In re Rouffet* and thus there is no motivation to combine the references based on the nature of the problems to be solved.

The teachings of the prior art: Koritzinsky teaches "an Imaging system protocol handling method and apparatus" (Title) and "A technique is disclosed for providing programs, such as operational protocols, to medical diagnostic institutions and systems. The protocols are created and stored on machine readable media. A description of the protocols is displayed at the diagnostic institution or system. A user may select a desired protocol or program from a user interface, such as a listing of protocols. The protocol listing may include textual and exemplary image descriptions of the protocols. Selected protocols are transferred from the machine readable media to the diagnostic institution or system. The transfer may take place over a network link, and may be subject to fee arrangements, subscription status verifications, and so forth. Protocols may be loaded for execution on system scanners by selection from the same or a similar protocol listing screen." (Abstract). Thus, Koritzinsky primarily teaches handling protocols of medical imaging services. Koritzinsky does not teach, suggest or even mention domain names or domain name registrations, anywhere, period. Thus, there is no motivation or suggestion in Koritzinsky whatsoever to provide a permanent domain registration and/or website hosting system.

The Appellant's invention has no connection whatsoever to medical diagnosis systems or protocols for medical imaging services and does not teach or suggest renewing subscriptions to such medical diagnosis systems. Thus, there is no motivation or suggestion in the Appellant's application to provide renewal subscriptions to medical imaging services.

Combining the Appellant's application with Koritzinsky is clearly an erroneous assertion by the Examiner in violation of the second prong of *In re Rouffet* and thus there is no motivation to combine the references based on the teachings of the prior art.

The knowledge of persons of ordinary skill in the art: Koritzinsky was filed in 1998. The Appellant's application was filed in June of 2001 claiming priority to a provisional patent application filed in June of 2000.

The Examiner asserts it would have been obvious to modify the Appellant's invention for a permanent domain registration system with a fee payment system for subscriptions to medical imaging services at the time the invention was made to make the claimed invention obvious based on the combination.

The Examiner must determine the knowledge of the persons of ordinary skill in art at the time the application was filed. To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. Knowledge of applicant's disclosure must be put aside in reaching this determination. The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and not based on applicant's disclosure. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136,

1143 n.5 (Fed. Cir. 1986) and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

In an article entitled the "History of the Internet" on Wikipedia, the free Internet encyclopedia at the URL http://en.wikipedia.org/wiki/History_of_the_Internet, teaches *on September 18, 1998 both IANA and InterNIC were reorganized under the control of ICANN, a California non-profit corporation to manage a number of Internet-related tasks. The role of operating the Domain Name System (DNS) system was privatized and opened up to competition, while the central management of name allocations would be awarded on a contract tender basis at a later time (1999, see below).*

In another electronic article at the URL http://en.wikipedia.org/wiki/Domain_name_registrar entitled "Domain Name Registrars" teaches *until 1999, there was no Shared Registration System (SRS). Network Solutions (NSI) operated the .com, .net, and .org registries, and was the de jure registrar and registry. However, several companies had set up as de facto registrars, including NetNames, who invented the idea of a commercial standalone domain name registration service in 1996. Registrars formed another link in the food chain, introducing the concept of domain name sales, effectively introducing the wholesale model into the industry. NSI followed suit, forcing the issue of separation of Registry and Registrar. In October 1998, following pressure from the growing domain name registration business and other interested parties, NSI's agreement with the US Department of Commerce was amended, requiring the creation of an SRS that supported multiple registrars. The SRS officially opened on November 30, 1999.*

The Appellant's application discloses similar information about the domain name registration system in the United States.

Koritzinsky was filed by GE Medical Systems on November 25, 1998, just one month after the DNS system in the United State was privatized and a full year before there was a domain name registration business with multiple public registrars. It is highly unlikely that Koritzinsky an inventor a GE Medical involved

with inventing medical imaging systems or any other person similarly skilled in the art in 1998 would have had conceived the Appellant's invention with just knowledge of the Koritzinsky invention including subscription services and domain names available from public registrars when the multiple public domain registrars didn't stop operating until a year later.

It is also highly unlikely that any other person skilled in the art, would in June of 2000, when the Appellant's provisional was filed would have created an invention as taught by the Appellant's claimed invention or could have included subscription services for medical imaging systems as taught by Koritzinsky when multiple public domain name registrars had only been operating for less than year to publicly register domain names at all.

In addition, Koritzinsky didn't issue in the United States until August 7, 2001, a month after the Appellant's Utility application was filed. The Appellant can find no evidence that the Koritzinsky was published in the United States at all is its filing preceded the AIPA of 1998 and the requirement that "Publication of patent applications is now required for the vast majority of filings made on or after November 29, 2000." Thus, no one skilled in the art, could have known about the Koritzinsky invention and used it to create new inventions.

The Examiner has not met his burden under the holdings of *Hodosh v. Block Drug Co., Inc., etc.* and *In re Mills.*

Stating one skilled in the art could have combined the Appellant's application with the Koritzinsky invention is clearly an erroneous assertion by the Examiner in violation of the third prong of *In re Rouffet* and thus there is no motivation to

combine the references based on knowledge of one of ordinary skill in the art at the time the Appellant's invention was filed.

In addition, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006).

The Federal Circuit emphasized that the proper inquiry for suggestion or motivation for an obviousness rejection is "whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination, *In re Fulton*, 391 F.3d 1195 (Fed. Cir. 2004).

"A statement that modifications of the prior art to meet the claimed invention would have been "*well within the ordinary skill of the art at the time the claimed invention was made* because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab,* 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000).

The Examiner has not met his burden under the holdings of *In re Kahn, In re Fulton Ex parte Levengood* or *In re Kotzab.* In fact the Examiner simply states the Appellant's application can be combined with Koritzinsky simply because "the type of subscription service is not critical since fee payment arrangements can be applied in any type of subscription service. (Second Office Action, page 6).

There is nothing in the prior art, including anything in the Background section of the Appellant's application that suggests modifying the Appellant's invention to include paying fees for subscription services for medical imaging systems as is taught by Koritzinsky. Its simply not necessary.

There is nothing in Koritzinsky either to suggest modifying Koritzinsky to create a permanent domain name registration since Koritzinsky does not teach, suggest or even mention domain names or domain name registrations. Period.

Thus, There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings based on the holding of the first prong of *In re Vaeck.*

II. There is no reasonable expectation of success to combine the Appellant's invention with Koritzinsky.

Evidence showing there was no reasonable expectation of success supports a conclusion of nonobviousness. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

There is no reason to include a subscription service for maintaining medical imaging systems with the Appellant's invention and there would not be any expectation of success of doing so. Koritzinsky includes a complex architecture specifically for medical imaging. (See FIGS. 1-16). Kortizinsky does not teach suggest or even mention domain name registrations.

There is no reason to include the components of Appellan'ts application in Koritzinsky since nothing taught by Koritzinsky is necessary to practice the Appellant's invention. The Appellant's invention teaches a different complex

architecture specifically for providing a permanent domain registration system and permanent website hosting system.

Thus, there is no reasonable expectation of success to combine the Appellant's invention with Koritzinsky or Koritzinsky with the Appellant's invention. This supports a conclusion of nonobviousness under the holding of *In re Rinehart.*

Thus, there is no reasonable expectation of success to combine the references as the Examiner suggests based on the holding of the second prong of *In re Vaeck.*

III. The prior art reference (or references when combined) do not teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success are not found in the prior art, but instead are improperly based on Appellant's disclosure.

Since the Examiner has not found any relevant prior art, the Examiner is relying heavily on the Appellant's own application to support his rejections.

The Examiner makes the following convoluted incorrect assertions to argue that Kortizinsky combined inappropriately with alleged AAPA teaches the claimed invention even though Kortizinsky does not teach suggest or even mention domain name registrations at all:

"In another subscription service, KORITZINSKY et al discloses several types of fee payment options (financial management arrangements) that may be provided to the subscriber for different levels of service, such as (a) pay-per-use, (b) periodically (yearly), or (c.) permanently, such as lifetime or non-expiring warranty service {see col. 21, lines I 5-50}. In view of the general problems with respect to the expired subscribed service for the domain name registration as mentioned in the AAPA, it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et alto obtain the benefit of lifetime or non- expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service, however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is "fee payment option" and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so

cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service. As for the limitation of "wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration", this reads over the limitation "lifetime or non-expiring warranty service" of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above."

In response to applicant's argument that AAPA and KORITZINSKY et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et alto obtain the benefit of lifetime or non-expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service, however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is "fee payment option" and facing with the problem of expiring of service due to nonpayment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service and subscription to diagnostic service is one of many teachings cited by KORITZINSKY et al. As for the limitation of "wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration", this reads over the limitation "lifetime or non-expiring warranty service" of KQRITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above. (Third Final Office Action, pages 6 and 7, pages 9 and 10, paragraph 11).

The Board will note the Examiner spends many words trying to convince the Appellant that the Appellant's claimed invention actually needs the unnecessary features for medical imaging systems taught by Koritzinsky. Of course none of these features is necessary since the Appellant's claimed invention already has the appropriate the features for providing a permanent domain name registration

system and a permanent website hosting system. It simply does not need any features taught by Koritzinsky.

To establish *prima facie* obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka,* 490 F.2d 981 (CCPA 1974).

The Board should note that even after this convoluted assertion the Examiner has not stated how the combination of alleged AAPA and Koritzinsky explicitly teaches all of the claim elements in violation of the holding of *In re Royka.*

In fact the Examiner the admits that the Applicant's application does not teach "a one-time permanent registration fee which would result in an issuing of a permanent registration certificate." (Second Office Action, page 5).

By the Examiner's own words and admissions not all of the claim limitations have been taught by alleged APPA alone or in combination with Koritzinsky.

The Examiner has thus clearly not established a *prima facie* case of obviousness for the claimed invention in violation of the holdings of *In re Royka.* Thus, Claim 1 is not obvious and the Section 103 rejection should be immediately withdrawn.

The Examiner is also appearing to rely on words he selected for the claims he wrote himself and the teachings of Koritznsky being equivalent and inherent to those claimed by the Applicant. The Examiner is reminded that in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and ***cannot be based on applicant's disclosure*** or the mere fact that the components at issue could be functional or mechanical equivalents. *In re Ruff,* 256 F.2d 590, 118 USPQ 340 (CCPA 1958) (or

based on words the Examiner makes up himself and claims are equivalent without any proof).

The Examiner asserted the Appellant's claim limitation of a "one time permanent registration fee used to perpetually pay all future renewal fees for the domain name registration" reads over Koritzinsky "a lifetime or non-expiring warranty service" and is inherently included in the teachings of Koritzinsky. (Third Final Office Action, page 7). The Examiner also asserted that the term "receipt" of the service request of Koritzinsky reads over the limitation "a permanent registration certificate" and is inherently included. These are clearly incorrect assertions. When does a "receipt" as taught by Koritzinsky suddenly rise to the level of a permanent registration certificate?

To establish inherency in the first place, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

The Examiner fails the equivalence and inherency tests because Koritzinsky does not teach, suggest or even mention domain names or domain name registrations. The Examiner has not provided any other prove from the prior art, other than the Appellant's own application that such an equivalence or inherency exists.

In fact, if the Board goes back and re-examines Table 1, the Board will see that the Examiner added to the claim he wrote the claim elements from Koritzinsky

that he later asserts are equivalent and inherent in the Appellant's claims. If such elements were truly equivalent and inherent, the Examiner would have not tried to make them additional claim elements that were added to the Appellant's claims as additional features.

The Examiner clearly has not met the burden of proof for equivalence under the holding of *In re Ruff* or for inherency under *In re Robertson.* No person skilled in any art, when viewing the teachings of Koritzinsky that teaches providing medical imaging system protocols for medical imaging system services and does not teach, suggest or even mention domain names, would inherently find a permanent domain name registration certificate or permanent domain name registration system or any of the other additional limitations described by the claimed invention.

The improper cite to alleged AAPA and Koritzinsky still does not teach all of the claim limitations, either explicitly or inherently as the Examiner suggests based on the holding of the third prong of *In re Vaeck.*

Other Rejected Dependent Claims:

The Examiner makes many assertions for the dependent claims that the features taught are inherent and obvious because the features are well known practices over the Internet.

The Applicant traverses these assertions because the none of these practices were well known at the time the Appellant's application was filed in 2001. In addition, none of these practices were obvious when fully considered with all of the limitations of the corresponding independent claims as described above and at the time the Appellant's application was filed. In addition, the Examiner again

improperly rejects the Appellant's claims over the Appellant's own application and alleged AAPA, which there is none.

The Appellant has also made arguments with respect to Independent claims 1, 14, 19, 25, 30 and 32. See previous pages. Thus, the Appellant has specifically pointed out the error's in the Examiner's assertions. The Appellant also requests the Board instruct the Examiner to provide proof from the prior art, and not from the Appellant's own application proofing these features were well known under 37 C.F.R. 1.104(c)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, the Board understands if an independent claim is non-obvious under 35 USC 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988). All of the dependent claims add additional limitations not present the independent claims. The Appellant has clearly pointed out why the independent claims not obvious. Thus, the dependent claims are not obvious either under the holding of *In re Fine* and their rejections must be immediately withdrawn.

CONCLUSION FOR REJECTION 3

Thus, the obviousness rejection is clearly improper under the holdings of *In re Vaeck* and the large number of other holdings cited herein. Therefore, the Examiner clearly has not established a *prima facie* case of anticipation under §103(a). Therefore, the Appellant now requests the Appeal Board instruct the Examiner to immediately withdraw the §103(a) rejections with respect to the cited claims. Since none of these claims is not obvious they should be immediately allowable in their present form.

ARGUMENT FOR REJECTION 4

The Appellant traverses the Examiner's rejection. All of the arguments for Issues 1 and 3discussed above are incorporated herein by reference.

As was discussed in detail above, the Appellant did not admit any of the claim elements of the claimed invention in the Background section of the application. All the Appellant did was provide a general background discussion. There is no AAPA that describes the claimed invention. Period. Enough said. As a result, the 103 rejection is improper on it face since Koritzinsky does not teach suggest or even mention domain names. Thus, the Examiner has clearly not provided a prima facie basis for obviousness under 35 U.S.C. §103(a)

Thus, the Appellant really need not respond any further. However, the Appellant responds as follows to point out all the remaining errors in the Examiner's assertions for the Board.

The Board is asked to turn to Appendix B and review the Appellant's response to these references in Appellant's First Response and Second Response.

The Examiner makes many assertions for these dependent claims that the features taught are inherent and obvious because the features are well known practices over the Internet and otherwise.

Neither Mann nor Cummings teach or suggest the features in these dependent claims as claimed by the Appellant in combination with corresponding independent claims.

The Applicant traverses these assertions because the none of these practices were well known at the time the Appellant's application was filed in 2001. In

addition, none of these practices were obvious when fully considered with all of the limitations of the corresponding independent claims as described above and at the time the Appellant's application was filed. In addition, the Examiner again improperly rejects the Appellant's claims over the Appellant's own application and alleged AAPA, which there is none.

The Appellant has also made arguments with respect to Independent claims 1, 14, 19, 25, 30 and 32. See previous pages. Thus, the Appellant has specifically pointed out the error's in the Examiner's assertions. The Appellant also requests the Board instruct the Examiner to provide proof from the prior art, and not from the Appellant's own application proofing these features were well known under 37 C.F.R. 1.104(c)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

If an independent claim is non-obvious under 35 USC 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988). These dependent claims add additional limitations not present the independent claims. The Appellant has clearly pointed out why the independent claims not obvious. Thus, the dependent claims are not obvious either under the holding of *In re Fine* and their rejections must be immediately withdrawn.

CONCLUSION FOR REJECTION 4

Therefore, the Appellant now requests the Appeal Board instruct the Examiner to immediately withdraw the §103(a) rejections with respect to the cited claims. Since none of these claims are not obvious they should be immediately allowable in their present form.

ARGUMENT FOR REJECTION 5

The Appellant traverses the Examiner's rejection. All of the arguments for Issues 1 and 3 discussed above are incorporated herein by reference.

As was discussed in detail above, the Appellant did not admit any of the claim elements of the claimed invention in the Background section of the application. All the Appellant did was provide a general background discussion. There is no AAPA that describes the claimed invention. Period. Enough said. As a result, the 103 rejection is improper on it face since Koritzinsky does not teach suggest or even mention domain names. Thus, the Examiner has clearly not provided a prima facie basis for obviousness under 35 U.S.C. §103(a)

Thus, the Appellant really need not respond any further. However, the Appellant responds as follows to point out all the remaining errors in the Examiner's assertions for the Board.

The Board is asked to turn to Appendix B and review the Appellant's response to these references in Appellant's First Response and Second Response.

Burnstein does not teach or suggest the features in these dependent claims as claimed by the Appellant in combination with corresponding independent claims.

The Applicant traverses these assertions because the none of these practices were well known at the time the Appellant's application was filed in 2001. In addition, none of these practices were obvious when fully considered with all of the limitations of the corresponding independent claims as described above and at the time the Appellant's application was filed. In addition, the Examiner again

improperly rejects the Appellant's claims over the Appellant's own application and alleged AAPA, which there is none.

The Appellant has also made arguments with respect to Independent claims 1, 14, 19, 25, 30 and 32. See previous pages. Thus, the Appellant has specifically pointed out the error's in the Examiner's assertions. The Appellant also requests the Board instruct the Examiner to provide proof from the prior art, and not from the Appellant's own application proofing these features were well known under 37 C.F.R. 1.104(c)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

If an independent claim is non-obvious under 35 USC 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988). These dependent claims add additional limitations not present the independent claims. The Appellant has clearly pointed out why the independent claims not obvious. Thus, the dependent claims are not obvious either under the holding of *In re Fine* and their rejections must be immediately withdrawn.

CONCLUSION FOR REJECTION 5

Therefore, the Appellant now requests the Appeal Board instruct the Examiner to immediately withdraw the §103(a) rejections with respect to the cited claims. Since none of these claims are not obvious they should be immediately allowable in their present form.

CONCLUSION FOR ALL ARGUMENTS

For the foregoing reasons, Appellant submits that all of the Examiner's rejection of claims 1-33 are clearly erroneous. Accordingly, Appellant respectfully requests that the Appeal Board reverse all of the Examiner's rejection of claims 1-33 and immediately pass all claims 1-33 to allowance.

Respectively submitted:

Lesavich High-Tech Law Group, P.C.

Date: October 24, 2007
(Original Filed August 28, 2007)

By: _____
Stephen Lesavich, PhD
Registration No. 43,749

CLAIMS APPENDIX

Claims 1-33:

1. **(Original)** A method for protecting domain name registrations with a permanent registration certificate, comprising:

accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;

accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; and

issuing a permanent registration certificate for the domain name registration based on the accepted information, wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

2. **(Original)** The method of Claim 1 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method.

3. **(Original)** The method of Claim 1 further comprising:

creating an electronic permanent registration certificate from the accepted information; and

storing an electronic permanent registration certificate in one or more databases associated with the permanent domain name registration system, wherein the stored electronic permanent registration certificate can be viewed via a computer network.

4. **(Original)** The method of Claim 1 further comprising:

issuing a domain name registration insurance policy with the permanent registration certificate, wherein the insurance policy covers financial losses associated with not properly renewing a domain name registration.

5. **(Original)** The method of Claim 1 further comprising:

issuing a domain name registration title with the permanent registration certificate, wherein the domain name registration title covers financial losses associated with not properly renewing a domain name registration.

6. **(Original)** The method of Claim 1 further comprising:

issuing a plurality shares in the domain name associated with the permanent registration certificate, wherein, the plurality of shares allow a plurality of ownership interests to be sold in the domain name registration associated with the permanent registration certificate.

7. **(Original)** The method of Claim 1 further comprising:

issuing leases or sub-leases for the domain name associated with the permanent registration certificate, wherein, the leases or sub-leases allow ownership interests to be reserved for a limited duration in the domain name registration associated with the permanent registration certificate.

8. **(Original)** The method of Claim 1 further comprising:

issuing co-ownership certificates for the domain name associated with the permanent registration certificate, wherein, co-ownership certificates allow two or more entities in two or more different locations to co-own one domain name registration associated with the permanent registration certificate.

9. **(Original)** The method of Claim 1 wherein the step of issuing a permanent registration certificate includes issuing an electronic permanent registration certificate or other than an electronic permanent registration certificate.

10. **(Original)** The method of Claim 1 wherein the one-time permanent registration fee is added to a financial instrument whose profits or interest is used to perpetually pay future renewal fees for the domain name registration.

11. **(Original)** The method of Claim 10 wherein the financial instrument includes an interest bearing account, a certificate of deposit, mutual funds, stocks, bonds or annuities.

12. **(Original)** The method of Claim 1 wherein the step of accepting a one-time permanent registration fee includes accepting a one-time permanent registration fee electronically over the Internet.

13. **(Original)** The method of Claim 1 wherein the step of accepting a one-time permanent registration fee includes accepting a one-time permanent registration fee other than electronically over the Internet.

14. **(Original)** A method for providing permanent registration of domain names, comprising:

(a) generating a list of domain name registrations from one or more databases associated with a permanent domain name registration system for which renewal fees on a public domain name registrar must be paid,
wherein the generated list of domain name registrations includes a plurality of domain name registrations for which a plurality of permanent registration certificate has been purchased,

wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees for the domain name registration at the public domain name registrar from the permanent domain name registration system;

(b) paying renewals fees electronically on the public domain name registrar for the list of generated domain name registrations;

(c) querying the public domain register to determine whether all of the domain name registrations from the generated list of domain name registrations have been renewed on the public domain name registrar, and if not,

(d) transferring additional renewal fees for any domain name registrations from the generated first list of domain name registrations that have not been renewed on the public domain name registrar, thereby ensuring renewal of domain name registrations, and

(e) notifying administrators at the permanent domain name registration system and the public domain name registrar of any renewal fee discrepancies; and

(f) repeating steps (a)-(c) periodically.

15. **(Original)** The method of Claim 14 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method.

16. **(Original)** he method of Claim 14 wherein the step of generating a list of domain name registrations includes generating a list of domain name registrations a pre-determined time period before renewal fees on a public domain name registrar must be paid.

17. **(Original)** The method of Claim 14 further comprising:

periodically comparing renewal dates for the plurality of domain name registrations on the permanent domain name registration system with the renewal dates on the public domain name registrar; and

notifying administrators at the permanent domain name registration system and the public domain name registrar of any renewal date discrepancies.

18. **(Original)** The method of Claim 14 further comprising:

periodically comparing renewal dates for the plurality of domain name registrations on the permanent domain name registration system with the renewal dates on the public domain name registrar;

determining from the permanent domain name registration system whether any renewal fees are due for any domain name registrations for which the public domain name registrar does not show a renewal fee is due, and if so,

transferring additional renewal fees for any such domain name registrations, and notifying administrators at the permanent domain name registration system and the public domain name registrar of any renewal date discrepancies.

19. **(Original)** A method for providing a permanent web-site, comprising:

accepting a domain name for which a permanent registration certificate has been issued, wherein the permanent registration certificate provides a permanent registration of the domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar from a permanent domain name registration system;

accepting electronic content for a permanent web-site to be associated with the domain name on the permanent domain name registration system;

accepting a one-time permanent web-site fee for hosting the domain name on the permanent domain name registration system, wherein the one-time permanent web-site fee is used to perpetually host the domain name on the permanent domain name registration system; and

perpetually hosting a permanent web-site accessible via the Internet for the domain name for which a permanent registration certificate has been issued.

20. **(Original)** The method of Claim 19 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method.

21. **(Original)** The method of Claim 19 wherein the one-time permanent web-site fee is added to a financial instrument whose profits or interest is used to perpetually pay administrative costs to host a web-site for the domain name accessible via the Internet on the permanent domain name system.

22. **(Original)** The method of Claim 21 wherein the financial instrument includes an interest bearing account, a certificate of deposit, mutual funds, stocks, bonds or annuities.

23. **(Original)** The method of Claim 19 wherein the step of perpetually hosting a web-site includes perpetually hosting the web-site on the permanent domain name registration system.

24. **(Original)** The method of Claim 19 wherein the step of perpetually hosting a web-site includes perpetually hosting the web-site on a host other than the permanent domain name registration system.

25. **(Original)** A method of providing co-use of a permanent registration of a domain name, comprising:

hosting a permanent domain name on a network server, wherein the permanent domain name is a domain name for which a permanent registration certificate has been issued, wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at a public domain name registrar from a permanent domain name registration system and wherein the permanent domain name is co-used by a plurality of co-users;

accepting a request for electronic content on the network server for one of the plurality of co-users using the permanent domain name;

determining which one of the plurality of co-users the request is for using information included in headers used with a protocol used to request the electronic content; and

directing the request to the determined co-user.

26. **(Original)** The method of Claim 25 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method.

27. **(Original)** The method of Claim 25 wherein the plurality of co-users are co-owners of the permanent domain name.

28. **(Original)** The method of Claim 25 wherein the plurality of co-users are leasing or sub-leasing the permanent domain name.

29. **(Original)** The method of Claim 25 wherein the step determining which one of the plurality of co-users the request is for using information included in headers used with a protocol used to request the electronic content includes determining which one of the plurality of co-users the request is for using an Internet Protocol address included in a header used with a protocol used to request the electronic content.

30. **(Original)** A permanent domain name registration system, comprising in combination:

a permanent registration certificate for providing permanent registration of a domain name, wherein the permanent registration certificate provides a permanent registration of a domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar; and

a plurality of servers associated with a plurality of databases accessible via the Internet for accepting information associated with a domain name registration obtained at the public domain name registrar, accepting a one-time permanent registration fee for the permanent registration certificate and for issuing the permanent registration certificate.

31. **(Original)** The system of Claim 30 wherein the plurality of servers associated with a plurality of databases include a Purchase/Payment server and associated database, an administrative server and associated database and a permanent web-site server and associated database.

32. **(Original)** A permanent domain name registration system, comprising in combination:

a permanent registration certificate for providing permanent registration of a domain name, wherein the permanent registration certificate provides a permanent registration of a domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar;

a permanent web-site for perpetually hosting a web-site associated with the domain name registration from an issued permanent registration certificate, wherein the web-site is accessible via the Internet; and

a plurality of servers associated with a plurality of databases accessible via the Internet for issuing a permanent registration certificate for a domain name registration, perpetually hosting a web-site associated with the domain name registration from an issued permanent registration certificate, wherein the web-site is accessible via the Internet, accepting a one-time permanent registration fee for the permanent registration certificate and accepting a one-time permanent web-site fee for perpetually hosting a web-site associated with the domain name registration from an issued permanent registration certificate.

33. **(Original)** The system of Claim 32 wherein the plurality of servers associated with a plurality of databases include a Purchase/Payment server and associated database, an administrative server and associated database and a permanent web-site server and associated database.

EVIDENCE APPENDIX

The Appellant has cited various sections of the following documents included as Exhibits A-F via this Evidence Appendix in the arguments in the preceding pages. All of these documents are part of the public record for the patent application either received from or sent to the USPTO, or published by the USPTO.

1. **First Office Action** – Exhibit A
2. **First Appellant Response** – Exhibit B
3. **Second Office Action** – Exhibit C
4. **Second Appellant Response** – Exhibit D
5. **Third Final Office Action** – Exhibit – E
6. **Published Patent Application 20020010795** – Exhibit F

RELATED PROCEEDINGS APPENDIX

None.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,408	06/07/2001	Charles P. Brown	00,464-A	7316

32097 7590 12/05/2005

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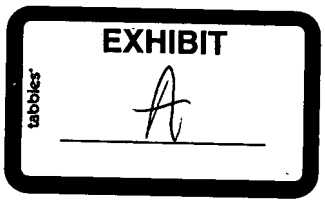
EXAMINER	
NGUYEN, NGHIA D	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary	Application No.	Applicant(s)	
	09/876,408	BROWN, CHARLES P.	
	Examiner	Art Unit	
	Patrick D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 12/22/04, 12/23/04, 3/09/05
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The U.S department of commerce, working under the authority of the Congress, is under contract with ICANN for the domain name registration, and therefore has no authority to grant a patent to a system that they have no jurisdiction over. In the memorandum of Understanding between Dept of Commerce and ICANN it states that ICANN business purpose is

i) coordinate the assignment of Internet technical parameters as needed to maintain universal connectivity on the Internet

ii) perform and oversee functions related to the coordination of the Internet Protocol (IP) address space

iii) perform and oversee functions related to the coordination of the Internet domain name system including the development of policies for determining the circumstances under which new top level domains names are added to the DNS root system.

Claim 1-33 are rejected on ground that they infringe on U.S laws set forth by Congress.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 1-13 and 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (or APPA) or Mann et al (U.S. patent No. 6,519, 589) in view of KORITZINSKY et al (U.S. patent No.6272469) in view of Hagan (U.S. patent No.6415267)

As for claim 1, AAPA fairly disclose the method of registration is well known . Accepting information from a public domain name registrar is necessary for any domain name registration system. Also, Mann et al teaches a method of obtaining information (plurality of names) from a public domain name registrar database for domain name registration (See Abstract). Mann discloses the invention except for :

Method of payment the fee or payment for service used (in this case, registration of domain name) i.e. accepting a one-time registration payment fee that can be used to perpetually pay for all future renewal fees for domain name registration instead of paying annually or pay-per-use.

KORITZINSKY et al is cited to teach the general concept of paying for a subscribed service such as (a) pay per use, (b) annually (c) periodically, or (d) permanently for the benefit of lifetime service or non-expiring warranty service with one-time payment of fee (one-time fee service) {see column 21, lines 16-31, col.22 lines 50-58}. It would have been obvious to modify the fee payment process of Mann et al by using option (d) or one-time payment of fee(one time fee service) as taught by KORITZINSKY et al for the benefit cited above, which is lifetime service or non-expiring warranty services. As for the limitation of "a permanent registration certificate", Mann et al would normally issue a registration certificate based on the type of payment of fee, and since this is in combination of KORITZINSKY et al , the issuance of a permanent registration certificate is inherently included or would have been obvious to a skilled artisan to do so if desired.

As for Claim 2, a computer medium (i.e. ram or any storage device) is inherently needed to store registration instruction.

As for Claim 3, a permanent registration certificate is inherently needed for receipt or proof or registration & purchase if a permanent registration took place and reference to claim 2, its inherent the information need a place to be store (i.e. database)

As for Claim 4, KORITZINSKY et al teaches a lifetime subscription warranty on the registration certificate (Column 21, paragraph 2, line 20). Warranty is an insurance that cover financial losses with not properly renewing.

As for Claim 5, issuing title to show a lifetime service/ ownership is a well know and concept, and it would be obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 6, issuing a plurality of shares is a well-known concept, corporation can sell shares to public to own, and invest in their company. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 7, issuing leases or subleases is a well known concept (i.e. house leasing, car leasing, anything can be leases, including domain names at sites like http://allfordomains.com/rent.asp/) It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 8, it is well known that you can have co-ownership of a property (joint-title, joint tenant ownership). It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 9, issuing an email certificate is well-known and obvious routine for online registration procedure. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 10, KORITZINSKY et al failed to teaches using the permanent registration fee to be added to a financial instrument whose profit can be use to perpetually pay for future renewal fees. However, Hagan (U.S. Pat 6415267) discloses investing in a financial instrument (Abstract line 6) whose profit can be release to pay contractually defining events (Abstract line 22) Motivation to combine KORITZINSKY et al and Hagan is to generate income to perpetually pay for future renewal cost. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 11, Hagan discloses investing in a financial program to generate fund (i.e. interest bearing accounts, mutual funds, stocks, bonds). It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 12, KORITZINSKY et al disclose accepting a one-time permanent registration fee. It is well known and obvious that an electronic fee is necessary since registration is taking place over the Internet. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for Claim 13, if registration fee doesn't take place over the Internet than it would be obvious to use U.S postal mail.

Claims 14-18 are rejected fewer than 35. U.S.C 103(a) as being unpatentable over Schneider (U.S. patent No.6901, 436) in view of KORITZINSKY et al.

As for claim 14, Schneider teaches a method, product, and apparatus for requesting a network resource (see Abstract, line 1-7), in which he teaches displaying query results for the plurality of domain names register in the domain registration system. Schneider teaching does not include: determine the renewal fee, paying the renewal fee, transferring additional renewal fee to maintain the right of the domain name. However, KORITZINSKY et al (Abstract, line 1-8) teaches a method of of determining, paying and verifying current and future renewal fee for registration subscription. (Column 23, line 5-15) Motivation to combine the teaching of Schneider with KORITZINSKY et al is to have automatic renewal system for domain name.

As for Claim 15, a computer medium (i.e. ram or any storage device) is inherently needed to store registration instruction.

As for Claim 16-18, KORITZINSKY et al teaches a method of renewal registration subscription including generating a listing of current registration holder (Column 19, line 10) and notifying personnel or renewal information (Column 24 line, 24-25)

Claim 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (or APPA) or Mann et al (U.S. patent No. 6,519, 589) in view of KORITZINSKY et al (U.S. patent No.6272469) in view of Hagan (U.S. patent No.6415267).

As for claim 19, 20, 23, 24. AAPA in view of KORITZINSKY et al disclose of method of Claim 1. Furthermore its obvious that any domain name registration system needs a web host to host the system and this web host have access to database to store instruction.

As for Claim 21 & 22, KORITZINSKY et al failed to teaches using the permanent registration fee to be added to a financial instrument whose profit can be use to perpetually pay for future renewal fees. However, Hagan (U.S. Pat 6415267) discloses investing in a financial instrument (Abstract line 6) whose profit can be release to pay contractually defining events (Abstract line 22) Motivation to combine KORITZINSKY et al and Hagan is to generate income to perpetually pay for future renewal cost. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 25, AAPA in view of KORITZINSKY et al disclose of method of Claim 1. Furthermore its obvious that any domain name registration system needs a web host to host the system and this web host have access to database to store instruction over a server because the nature of the system is dependent on being "online" . It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 26, it obvious that a online registration system would need a computer medium, database, and connect over a server to work. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 27, it is well known that you can have co-ownership of a property (joint-title, joint tenant ownership). It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 28, issuing leases or subleases is a well known concept (i.e. house leasing, car leasing, anything can be leases, including domain names at sites like http://allfordomains.com/rent.asp/) It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

As for claim 29, Furthermore co-use of a permanent registration of a domain name is obvious. A domain name for corporation (i.e. I.B.M) is used by many individual. Claim 29 refers to subdomain or secondary URL, in requesting for protocol address, a well-known concept. (i.e. www.permanent.com/john , www.permanent.com/bob/)

As for Claim 30-34, KORITZINSKY et al failed to teaches using the permanent registration fee to be added to a financial instrument whose profit can be use to perpetually pay for future renewal fees. However, Hagan (U.S. Pat 6415267) discloses investing in a financial instrument (Abstract line 6) whose profit can be release to pay contractually defining events (Abstract line 22) Motivation to combine KORITZINSKY et al and Hagan is to generate income to perpetually pay for future renewal cost. It would have been obvious to implant these component into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service benefit/guarantee as taught by KORITZINSKY et al and in further view of Hagan.
It is obvious that a online registration system would need a computer medium, database, and connect over a server to work. It would have been obvious to implant these component into domain name registration system as taught by AAPA or Mann et al and in further view of lifetime service/benefit/guarantee as taught by KORITZINSKY et al.

All Claims are rejected

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Nguyen whose telephone number is 7038395713. The examiner can normally be reached on 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Weiss can be reached on to 571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(LHTLG No. 00,464-A)

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In re Application of: Brown

Serial No. 09/876,408

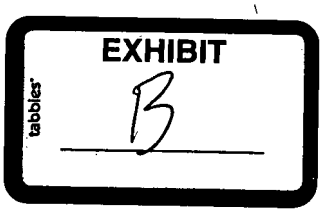
Filed: June 7, 2001

For: METHOD AND SYSTEM FOR PROTECTING DOMAIN NAMES

Examiner: Nguyen, Nghia D.

Group Art Unit: 3629

Confirmation No. 7816



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RESPONSE TO OFFICE ACTION

MAILED December 5, 2005

Responsive to the First Office Action mailed December 5, 2005, Applicant submits the following Response.

RESPONSE

Remarks

Claims 1-34 are pending in the Application. Claims 1, 10, 16 and 20 are in independent format. Applicant now responds to the Examiner's assertions.

The Applicant asks the Examiner carefully consider the comments below with an open mind. If the Examiner carefully and realistically considers the comments below with an open mind the Examiner will see that the rejections are

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improper, violate the holdings of many different court decisions and cannot be maintained.

Section §101 Rejection

The Examiner asserts that "claims 1-33 are rejected on the ground that they infringe on U.S. laws set forth by Congress. The U.S. department of commerce, working under the authority of Congress, is under contract with ICANN for the domain name registration system that they may have no jurisdiction over." The Applicant traverses all of the Examiner's assertions.

Section101 Response

First, the United States Patent and Trademark Office (USPTO) has issued seven patents that include the terms "domain name registration" in the claims. See Table 1 below created by the searching the USPTO web site at www.uspto.gov on June 5, 2006. In addition, there are 25 published patent applications what include the terms "domain name registration" in their claims.

1	7,039,697	Registry-integrated internet domain name acquisition system
2	7,020,602	Native language domain name registration and usage
3	6,980,990	Internet domain name registration system
4	6,895,430	Method and apparatus for integrating resolution services, registration services, and search services
5	6,760,746	Method, product, and apparatus for processing a data request
6	6,678,717	Method, product, and apparatus for requesting a network resource
7	6,167,449	System and method for identifying and locating services on multiple heterogeneous networks using a query by type

Table 1.

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Table 2 includes an additional 13 issued patent that include the terms "domain name registry" in the claims.

1	7,039,697	Registry-integrated internet domain name acquisition system
2	7,003,661	Methods and systems for automated authentication, processing and issuance of digital certificates
3	7,000,028	Automated domain name registration
4	6,980,990	Internet domain name registration system
5	6,854,074	Method of remotely monitoring an internet web site
6	6,842,770	Method and system for seamlessly accessing remotely stored files
7	6,839,759	Method for establishing secure communication link between computers of virtual private network without user entering any cryptographic information
8	6,826,616	Method for establishing secure communication link between computers of virtual private network
9	6,735,585	Method for search engine generating supplemented search not included in conventional search result identifying entity data related to portion of located web page
10	6,687,733	Method and system for automatically configuring a client-server network
11	6,519,859	System and method for generating domain names and for facilitating registration and transfer of the same
12	6,654,813	Dynamically categorizing entity information
13	6,018,761	System for adding to electronic mail messages information obtained from sources external to the electronic mail transport process

Table 2.

These patents issued to individuals and organizations, as far as the Applicant can tell, are not related to ICANN. If the USPTO has no authority to grant a patent including domain name registrations or registries, how did the USPTO grant such patents already? Patent 7,039, 697 entitled "Registry-integrated internet domain name acquisition system," was granted on May 2, 2006. Clearly, this wasn't illegal and the USPTO had the authority to grant such a patent.

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If the Examiner is correct, which does not appear to be the case, the USPTO has already violated U.S. laws set forth by Congress by issuing the patents in Tables 1 and Table 2. If the Examiner is incorrect, and that appears to be the case in the matter, the USPTO is not treating all applicant's for patents related to domain names fairly in violation of the patent rules.

Second, the Applicant's invention includes, in general, managing domain name registrations obtained from a public domain name registrar and paying fees back to the public domain name registrar to maintain a permanent domain name registration. This clearly can not and does not infringe on the laws of the United States as set forth by Congress or their contract with ICANN as the public domain name register issues the domain name registrations and is paid for their maintenance.

Third, if the Applicant's invention did violate the laws the United States, why did the Examiner further apply the patent laws of the United States and reject the Applicant's invention under Section 103 of the patent laws? If what the Examiner asserted was true, there would be no need to further apply any additional sections of the patent laws.

Fourth, the Examiner cited the U.S. Patent No. 6,519,589 to Mann et al. against the Applicant which a patent invention including a system for generating a domain name and for facilitating its registration with a public domain name registrar. If the Mann invention does not infringe U.S. law as set forth by Congress how can the Applicant's?

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The Examiner has clearly incorrectly applied Section 101. The Applicant requests the Section 101 rejection be immediately withdrawn.

First Section 103 Rejection

Claims 1-13 and 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann (U.S. Patent No. 6,519,589) in view of Koritzinsky (U.S. Patent No. 6,272,469) in view of Hagan (U.S. Patent No. 6,415,267).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

First Section 103 Response

The Examiner is reminded that to establish prima facie obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974). A *prima facie* case of obviousness may also be rebutted by showing in the cited art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997).

Claim 1

Claim 1 recites "*a method for protecting domain name registrations with a permanent registration certificate, comprising (1) accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system; (2) accepting a one-time permanent registration fee for the domain name registration on the permanent domain name*

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registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; (3) storing the accepted information in one or more databases associated with the permanent domain name registration system; (4) issuing a permanent registration certificate for the domain name registration, wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system." (Parenthesized numbers not in original claim added by Applicant in this paper for discussion purposes only).

First, the Examiner asserted that Claim 1 is rejected over "Applicant Admitted Prior Art." However, the Applicant did not file any Information Disclosure Statements (IDS) that included the two patents, Mann, or Koritzinsky as cited by the Examiner as Applicant Admitted Prior Art.

Second with respect to the patent to Hagan, the Applicant filed an IDS including a the Hagan patent. However, the Applicant made no such admissions with respect to Hagan being relevant prior art. The Applicant clearly states in the letters filed with each of the IDSs that *"The references have not been reviewed in sufficient detail to make any other representation and, in particular, no representation is indented as to the relative importance of any portion of the references. This Statement is not a representation that the cited references have effective dates early enough to be 'prior art' within the meaning of 35 U.S.C. sections 102 or 103."*

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Third, the Examiner rejected Claim 1 in part in view of Hagan. However the Examiner provided no assertions or commentary for Hagan with respect to Claim 1. Clarification is requested as to the rejections of Claim 1 in view of Hagan.

Next, the Examiner asserts that Mann teaches " a method of obtaining information (plurality of names) from a public domain registrar for domain name registration (See Abstract)." By the Examiner's own words this does not match what is recited by the first element of Claim 1 which recites "*accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;*"

In contrast to the Examiner's assertions, Mann actually teaches a "System and method for generating domain names and for facilitating registration and transfer of the same." (Title). This teaches away from what is recited by the first element of Claim 1 which includes obtaining information for a domain name that has been already registered with a public domain name registrar.

Third, Mann further teaches "New and improved systems and methods for generating and facilitating registration and transfer of available domain names. The systems and methods include and involve a data storage facility for storing at least one adjunct term for use in generating at least one registerable domain name, and a processor arrangement which is coupled to the data storage facility and which is configured to be accessed by a user system via an electronic data network, to receive at least one root term from the user system, to concatenate at least one root term with at least one adjunct term to generate at least one candidate domain name, to query a data source to determine if the candidate domain name(s) is available for

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registration and/or transfer, and to notify the user system of the candidate domain name(s) when the same are available for registration and/or transfer." (Abstract)

Thus, the Abstract cited by the Examiner includes teachings that not only teach away from the claimed invention but also clearly does not teach or suggest the first element of Applicant's Claim 1.

The Examiner then admits that Mann does not teach or suggest the claim elements two and part of four of Claim 1 of "*accepting a one-time registration payment fee that can be used to perpetually pay for all future renewal fees for domain name registration instead of paying annually or pay-per-use.*"

The Examiner is reminded that to establish *prima facie* obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974).

Since Mann does not teach or suggest element one as discussed above or element two or part of four by the Examiner's own admissions, the Examiner has not established a *prima facie* case of obviousness for the claimed invention in view of Mann in violation of the holdings of *In re Royka*. Thus, Claim 1 is not obvious and the Section 103 rejection should be immediately withdrawn.

The Applicant need not respond any further. However, for completeness the Applicant responds as follows.

The Examiner is reminded that even if a case of *prima facie* obviousness is established, which is not the case in the matter as was described above, a *prima facie* case of obviousness may be rebutted by showing in the cited art, in any

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material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997).

Mann clearly teaches away from the claimed invention by requesting root terms, generating domain names using the root terms and determining if the generated domain name is available for registration (Abstract). This clearly teaches away from the Applicant's invention as recited by Claim 1 which has not such limitations.

In addition, Mann clearly teaches "Registration should be interpreted to mean that an available domain name generated in accordance with the present invention may be registered (e.g., such as via a domain name registration authority)." Col. 8, lines 4-6. This clearly teaches away from the Applicant's invention as recited by Claim 1. Thus, if a *prima facie* case of obviousness did somehow exist in view solely of Mann, the Applicant has also rebutted it based on the holding of *In re Geisler*.

The Examiner is also reminded that obviousness can only established by combining the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no motivation to make the proposed modification. *In Re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). If a proposed modification or combination of the prior art would change the principle

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operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti* 270 F.2d 810 (CCPA 1959).

The Examiner then asserts Koritzinsky et al teaches the "general concept of paying for a subscribed service such as (a) pay per use, (b) annually (c) periodically, or (d) permanently for the benefit of lifetime service or non-expiring warranty service with one-time payment of fee (one-time service) (See column 21, lines 16-31, col. 22, lines 50-58). It would have been obvious to modify the fee payment process of Mann by using option (d) or one-time payment of fee (one time fee service) as taught by Koritizinsky for the benefit as cited above, which is lifetime service or non-expiring warranty services."

First, Mann does teach suggest or even mention a payment process for domain names as the Examiner asserts. If the Examiner thinks that Mann teaches a fee payment process the Applicant requests the Examiner specifically state the column and lines in Mann where a fee payment process is taught or suggested.

Second, Koritzinksky teaches "an Imaging system protocol handling method and apparatus" (Title) and "A technique is disclosed for providing programs, such as operational protocols, to medical diagnostic institutions and systems. The protocols are created and stored on machine readable media. A description of the protocols is displayed at the diagnostic institution or system. A user may select a desired protocol or program from a user interface, such as a listing of protocols. The protocol listing may include textual and exemplary image descriptions of the protocols. Selected protocols are transferred from the machine readable media to the

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diagnostic institution or system. The transfer may take place over a network link, and may be subject to fee arrangements, subscription status verifications, and so forth. Protocols may be loaded for execution on system scanners by selection from the same or a similar protocol listing screen." (Abstract). Thus, Koritzinsky primarily teaches handling protocols of medical imaging services.

Third, Koritzinsky does not teach, suggest or even mention domain names or domain name registrations anywhere, period.

Fourth, combining Mann and Koritzinsky still does not teach or suggest what is recited by the claimed invention. Mann teaches a method for generating domain names and for facilitating registration of the domain names. (Abstract). Koritzinsky teaches an imaging system protocol handling method and apparatus for medical imaging (Title and Abstract). Adding a one-time payment for medical imaging diagnostic services from Koritzinsky to the system and method for generating and facilitating registration of domain names does not teach or suggest what is recited by the claimed invention.

Fifth, there is no motivation to combine Mann with Koritzinsky because because Koritzinsky changes at least one principal operation of Mann and renders Mann unsatisfactory for one of its intended purposes in violation of the holdings of *In re Fine*, *In Re Gordon* and *In re Ratti*.

For example, Mann teaches generating a domain name from a root word obtained from a user, checking the availability of the generated domain name, notifying a user of the availability of a domain name and allowing a user an option

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to register an available domain name with a domain name registrar (Abstract, Col. 3, line 40 through Col. 8, line 16 and Claims.).

Mann clearly teaches at Col. 8, lines 4-7, "In the preceding discussion, registration of available domain names has been mentioned as an option related to an available domain name generated in accordance with the present invention... Registration should be interpreted to mean that an available domain name generated in accordance with the present invention may be registered (e.g., such as via a domain name registration authority).

Thus, there is no motivation to combine Mann and Koritizinsky as the Examiner suggests. Even if Mann and Koritzinsky were combined, the combination still does teach or suggest the claimed invention as the Examiner suggests.

The Examiner further asserts that "as for the limitation of a permanent registration certificate, Mann would normally issue a registration certificate based on the type of payment of fee."

This is an incorrect statement based on the teachings of Mann. As was discussed above Mann clearly teaches "Registration should be interpreted to mean that an available domain name generated in accordance with the present invention may be registered (e.g., such as via a domain name registration authority)." Col. 8, lines 4-6. This it is the domain name authority and not Mann that issues the domain name registration certificate.

Finally, the Examiner asserts that "the issuance of a permanent registration certificate is inherent included in combination with Koritzinsky." This is again an incorrect statement since Mann does not issue domain name registration

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certificates, the domain name registration authority does so Mann does not explicitly or inherently teach issuing a domain name registration certificate. In addition, Koritzinsky does not explicitly or inherently teach or suggest a permanent domain name registration certificates because Koritzinsky does not teach or suggest or even mention domain names.

Thus, there is no motivation to combine Mann and Koritzinsky. Trying to do so violates the holdings of *In re Fine, In Re Gordon* and *In re Ratti.*

The Applicant has clearly shown why Claim 1 is not obvious over Mann in view of Koritzinsky. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claim 1. Since this claim is not obvious it should be immediately allowable in its present form.

Claims 2-9

The Examiner is reminded that if an independent claim is non-obvious under 35 USC 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

All of arguments for Claim 1 are incorporated by reference. Claims 2-9 add additional limitations not present in Claim 1.

The Applicant has clearly pointed out why Independent Claim 1 is not obvious. Thus, Claims 2-9 are not obvious under the holding of *In re Fine.*

In addition, Applicant responds to the Examiner's assertion that the additional limitations described in Claims 2-9 are inherent.

The Examiner is reminded that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the

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thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

The Examiner clearly has not met the burden of proof for inherency under *In re Robertson*. No person skilled in the art, when viewing the teachings of Koritzinsky that teaches providing medical imaging system protocols for medical imaging system services and does not teach, suggest or even mention domain names, would inherently find a permanent domain name registration certificate, a lifetime subscription warranty, plural shares in the permanent domain name registration, a lease on the permanent domain name registration, co-ownership on the permanent domain name registration or any of the other additional limitations described by Claims 2-9.

In addition, the Applicant traverses all of the Examiners assertions of concepts described by the limitations in Claims 2-9 as being well known. The Examiner's assertions include several errors with respect to Claims 2-9. None of the concepts the Examiner described as well known had ever been associated with permanent domain name registrations. In fact most of the statements the Examiner asserted as well known are not even well know with respect to the Internet. And certainly not well known with respect to use with domain names or permanent domain name registrations.

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Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 2-9. Since these claims are not obvious they should all be immediately allowable in there present form.

Claims 19-34

All of arguments for Claim 1 are incorporated by reference. Claims 19-34 include similar claim limitations related to permanent domain name registrations as are recited by Claim 1.

The Applicant has clearly pointed out why Independent Claims 1 is are not obvious. Thus, Claims 19-34 are not obvious by the same arguments outlined for Claim 1.

Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 19-34. Since these claims are not obvious they should all be immediately allowable in there present form.

Second Section 103 Rejection

Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mann (U.S. Patent No. 6,519,589) in view of Koritzinsky (U.S. Patent No. 6,272,469) in view of Hagan (U.S. Patent No. 6,415,267).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

Second Section 103 Response

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PAGE 17/21 * RCVD AT 6/5/2006 5:59:05 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/30 * DNIS:2738300 * CSID:3123323752 * DURATION (mm-ss):07-58

Claim 10

The Applicant accepts the Examiner's *admission* that Koritzinsky *"failed to teach using the permanent registration fee to be added to a financial instrument who profit can be used to perpetually pay future renewal fees."*

The Examiner further asserts, Hagan discloses investing in a financial instrument (Abstract line 6) whose profit can be release to pay by contractually defining events (Abstract line 22). Motivation to combine Koritzinsky and Hagan is to generate income to peretually pay for future renewal cost. It would have been obvious to implant this into domain name registration system as taught by AAPA or Mann and in further view of lifetime/service/benefit/guarantee as taught by Koritzinsky."

All of the arguments for Claim 1 above are incorporated by reference for Claim 10 and further apply in view of Hagan. The combination of these three references still does not teach or suggest the claimed invention claimed by Claim 10.

Thus, Claims 10 is not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 10 in view of Hagan. Since this claims is not obvious it should all be immediately allowable in its present form.

Third Section 103 Rejection

Claims 14-18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider (U.S. Patent No. 6,901, 436 in view of Koritzinsky (U.S. Patent No. 6,272,469).

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The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

Third Section 103 Response

Claims 14-18

The Applicant accepts the Examiner's admission that Schneider does not teach "*determining a renewal fee, paying a renewal fee, transferring additional renewal fee payments to maintain the right of the domain name.*"

Neither Schneider nor Koritzinsky teach, suggest or even mention permanent domain names or permanent domain name registrations claimed by the Applicant.

All of the arguments for Claims 1 and 10 above are incorporated by reference in view of Schneider. The combination of these three references still does not teach or suggest the claimed invention.

Thus, Claims 14-18 is not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 14-18 in view of Schneider. Since this claims is not obvious it should all be immediately allowable in their present form.

Fourth Section 103 Rejection

Claims 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann (U.S. Patent No. 6,519,589) in view of Koritzinsky (U.S. Patent No. 6,272,469) in view of Hagan (U.S. Patent No. 6,415,267).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the

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Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

Fourth Section 103 Response

Claims 19-34

Applicants accepts all of the Examiner's *admissions* with respect to Claims 21, 22, and 30-34.

All of the arguments for Claims 1 and 10 above are incorporated by reference. The combination of these three references still does not teach or suggest the claimed invention.

The Examiner is reminded that to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*.

The Examiner clearly has not met the burden of proof for inherency under *In re Robertson*. No person skilled in the art, when viewing the teachings of Koritzinsky that teaches providing medical imaging system protocols for medical imaging system services and does not teach, suggest or even mention domain names, would inherently find a permanent domain name registration certificate, a lifetime subscription warranty, plural shares in the permanent domain name registration, a lease on the permanent domain name registration, co-ownership on the permanent domain name registration or any of the other additional limitations described by the claims.

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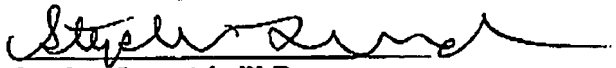
In addition, the Applicant traverses all of the Examiners assertions of concepts described by the limitations in these as being well known. The Examiner's assertions include several errors with respect to claims. None of the concepts the Examiner described as well known had ever been associated with permanent domain name registrations. In fact most of the statements the Examiner asserted as well know are not even well know with respect to the Internet.

Thus, Claims 19-34 are not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 19-34. Since this claims is not obvious it should all be immediately allowable in their present form.

CONCLUSION

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited references for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §101 and §103 rejections of claims 1-34 and pass all of the claims immediately to allowance.

Respectfully submitted.
Lesavich High-Tech Law Group, PC (32097)



Dated: June 6, 2006

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,408	06/07/2001	Charles P. Brown	00,464-A	7316

32097 7590 08/25/2006

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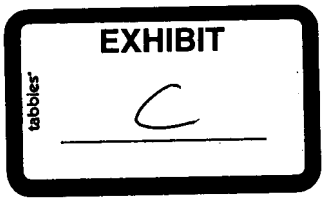
EXAMINER	
NGUYEN, TAN D	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary	Application No.	Applicant(s)	
	09/876,408	BROWN, CHARLES P.	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 2-4, filed 6/5/06, with respect to the 101 rejections have been fully considered and are persuasive. The rejections of claims 1-33 under 101 rejections are withdrawn.

Claim Rejections - 35 USC § 112

2. Claims 1-13, 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 5, the 2nd step of "accepting a one-time permanent registration fee" is vague and indefinite. From the specification, it appears this phrase appears to mean "accepting a one-time permanent registration fee payment" and therefore, insertion of the term "payment" after "fee" is recommended to improve clarity.

Similarly, claims 19-24, are rejected for the same reasons set forth in claims 1-13 above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-3, 9, 12-13, 14-18, 19-20, 23-24, 25-29, 30-31, 32-33, which are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of KORITZINSKY et al.

Claim 1 is as followed:

1. A method for protecting domain name registrations with a permanent registration certificate, comprising:

accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;

accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; and

issuing a permanent registration certificate for the domain name registration based on the accepted information, wherein the permanent registration certificate provides a

permanent registration the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

Claim 1 reads over:

A method for protecting a subscription service with a permanent service certificate wherein the service is domain name registrations subscription, comprising:

accepting information associated with a subscription service, wherein the subscription service is domain name registration obtained from a public domain name registrar on a domain name registration system;

accepting a one-time permanent registration fee for the subscription service wherein the subscription service is domain name registration, on a permanent subscription service system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the subscription service; and

issuing a permanent service certificate based on the accepted information, wherein the subscription service is domain name registration, and the permanent service certificate is about domain name registration and the certificate provides a permanent registration the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

As shown under the "Background of the Invention" in the specification, the domain name registration basically is subscription **service** that identifies and protect the IP addresses to make it easier for people to identify the sites on the Internet. Every year, each subscriber has to pay $35.00/year for the maintaining of the service {see page 4, last paragraph}.

Similarly, as indicated in the specification, under "Background of the Invention", **AAPA** fairly discloses a method for domain name registrations service with a annual registration receipt (certificate), comprising:

(a) accepting information associated with a domain name registration (subscription service) obtained from a public domain name registrar on a domain name registration system {see page 3, last two paragraphs};

(b) accepting a yearly (annual) payment of registration fee for the domain name registration (subscription service) on the annual domain name registration system {see page 4, last paragraph}; and

(b) issuing an annual registration certificate (receipt) for the domain name registration based on the accepted information {see pages 4-6, see "a domain name can registered electronically at nsi.com" on page 3, line 19-21}.

AAPA fairly teaches the claimed invention except for the type of fee payment for subscription (registration) service from annual payment ($35.00/year) to a one-time permanent registration fee with would result in an issuing of a permanent registration certificate (receipt) in step (c.), for example a payment of $3,500 to cover 100 years or $1,000,000 for perpetually permanent service).

In another subscription service, KORITZINSKY et al discloses several types of fee payment options (financial management arrangements) that may be provided to the subscriber for different levels of service, such as (a) pay-per-use, (b) periodically (yearly), or (c.) permanently, such as lifetime or non-expiring warranty service {see col. 21, lines 15-50}. In view of the general problems with respect to the expired subscribed service for the domain name registration as mentioned in the AAPA , it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the benefit of lifetime or non-expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service, however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is "fee payment option" and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service.
As for the limitation of "wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration", this reads over the limitation "lifetime or non-expiring warranty service" of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.

As for the limitation of a certificate, this reads over the term "receipt of the service request" as shown in col. 21, line 24-26. As for the limitation "a permanent registration certificate", this is taught in AAPA / KORITZINSKY et al when "life time" service is selected/requested and the receipt of the service requested would inherently include the "permanent service".

6. As for dep. claim 2 (part of 1 above), which deals with well known computer readable medium having stored therein instructions for causing a processor to execute the steps of method claim 1, this is inherently included in the online system of AAPA /KORITZINSKY et al.

7. As for dep. claims 3, 9 (part of 1 above), which deals with well known information displaying parameters, i.e. certificate or receipt of fee payment for service, this is fairly taught in Fig. 1, Fig. 15, Fig. 8, "212", "PROBLEM DESCRIPTION".

8. As for dep. claims 12-13 (part of 1 above), which deals with well known payment parameters, i.e. electronically or manually, these are inherently included in the registration over the Internet as taught in AAPA. Alternatively, the manual payment of fee by mail or other would have been obvious because this is well known practice.

As for method claims 14-18, 19-20, 23-24, 25-29, 30-31, 32-33, which basically have the same limitations as in claims 1-3, 9, 12-13 above, they are rejected for the same reasons set forth above.

9. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA /KORITZINSKY et al as applied to claims 1-3, 9, 12-13, above, and further in view of MANN et al and CUMMINGS et al .

As for dep. claims 4-5 (part of 1 above), the teachings of AAPA /KORITZINSKY et al is cited above. MANN et al, as shown on col. 2, lines 4-18, is cited to disclose well known facts that many domain names have been registered by sellers/brokers as assets (equity) which may be sold for large sums of money for acquiring or transferring and using of the domain names to point to their content sources.

CUMMINGS et al is cited to teach well known business practice of obtaining insurance policy and title for an equity /asset to cover financial losses associated with the equity, thus protecting the equity/asset investment in case of losses {see col. 1, lines 15-20, claim 1}. It would have been obvious to modify the teachings of AAPA /KORITZINSKY et al by obtaining insurance policy and title as taught by CUMMINGS et al for the domain name registration to protect the domain names since MANN et al discloses that domain names are valuable assets/equity that can be sold for large sums of money.

10. Claims 6-8, 10-11, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA /KORITZINSKY et al as applied to claims 1-3, 9, 12-13, 19-20 above, and further in view of BURSTEIN et al.

As for dep. claims 6-8, 10-11 (part of 1 above) and 21-22 (part of 19 above), the teachings of AAPA /KORITZINSKY et al is cited above. BURSTEIN et al is cited to teach well known facts that many domain names have been registered by

sellers/brokers as assets (equity) which may be sold for large sums of money for acquiring or transferring and using of the domain names and many cases, the registrant may incorporate one or more domain names into an organization identity or business {see col. 2, lines 40-50}. As for dep. claims 6-8 and 10-11, which deal with well known business parameters for carrying out a business or corporation such as issuing shares, issuing leases or sub-leases of an asset, etc., and the practices of these business parameters in the teachings of AAPA /KORITZINSKY et al would have been obvious as routine business parameters.

Response to Arguments

11. Applicant's arguments filed 6/12/06 have been fully considered but they are not persuasive.

In response to applicant's argument that AAPA and KORITZINSKY et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, In view of the general problems with respect to the expired subscribed service for the domain name registration as mentioned in the AAPA , it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the benefit of lifetime or non-expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service,

however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is "fee payment option" and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service and subscription to diagnostic service is one of many teachings cited by KORITZINSKY et al.

As for the limitation of "wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration", this reads over the limitation "lifetime or non-expiring warranty service" of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.

12.

No claims are allowed.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see http://pair-direct@uspto.gov. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

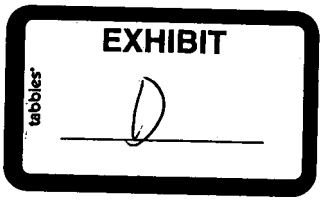
dtn
August 21, 2006

DEAN T. NGUYEN
PRIMARY EXAMINER

O I P E
FEB 13 2007
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(LHTLG No. 00,464-A)

In re Application of:	
Brown	Examiner: **Nguyen, Tan D.**
Serial No. **09/876,408**	Group Art Unit: **3629**
Filed: **June 7, 2001**	Confirmation No. **7316**
For: **METHOD AND SYSTEM FOR PROTECTING DOMAIN NAMES**	



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Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

RESPONSE TO OFFICE ACTION

MAILED August 25, 2006

Responsive to the First Office Action mailed August 25, 2006, Applicant submits the following Response.

RESPONSE

Remarks

Claims 1-33 are pending in the Application. Claims 1, 10, 16 and 20 are in independent format. Applicant now responds to the Examiner's assertions. The Applicant has many grounds for which to appeal this matter and will file immediately a Notice of Appeal should the Examiner not reconsider the current rejections and withdraw them.

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Paragraph 11 – Response to Arguments in Previous Office Action

The Applicant traverses all of the Examiner's assertions and accepts all of the Examiner's admissions.

The Applicant acknowledges that the Examiner admits he made a mistake in rejecting claims 1-33 on the ground that they infringed on U.S. laws set forth by Congress and the Applicant could not apply for any patent protection at all for any invention related to domain names since and the U.S. Department of Commerce was working under the authority of Congress and was under contract with ICANN for the domain name registration system that the U.S. Department of Commerce had no jurisdiction the domain name system for patent protection. The Applicant acknowledges that the Examiner withdraw this improper rejection.

In the previous Office Action, the Examiner, initially argued the claimed invention was obvious under 35 U.S.C. 103(a) as being unpatentable over Mann (U.S. Patent No. 6,519,589) in view of KORITZINSKY (U.S. Patent No. 6,272,469) in view of Hagan (U.S. Patent No. 6,415,267).

The Examiner has not mentioned this rejection in the current office action. The Examiner has not stated as whether this rejection was withdrawn or is still in place. He only states that the Applicant's arguments to this rejection in the Applicant's response filed June 5, 2006 were not persuasive.

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If the Applicant's argument were not persuasive, why did the Examiner not maintain this rejection? If the Applicant's arguments were persuasive, the Applicant requests the Examiner state for the record why they were.

Applicant requests the Examiner state for the record the status of this rejection from the previous office action with respect to the present office action.

The Applicant asserts the Examiner has mis-applied U.S. Patent Law and the associated rules several times by sending out the current Office Action. First, this second non-final rejection of this current Office Action is improper under the patent rules. Since the Applicant did not amend the claims in the previous Office Action, the Examiner was required under the patent rules to either allow all the claims or finally reject the claims. The Examiner's actions are improper and inequitable under the patent rules.

The Examiner, after reading the Applicant's previous response, commented only on the Applicant's arguments with respect to the single reference KORITZINSKY. The Examiner, apparently feeling KORITZINSKY is the Examiner best chance to reject the Applicant's claims based on the comments made by the Applicant's in its response, then created a brand new rejection over the Applicant's application itself and KORITZINSKY. The Examiner also did a new search and created new rejections with new references Cummings and Burstein. A new search was not appropriate or necessary since the Applicant did not amend the claims. These actions by the Examiner violate MPEP rule 706.07. MPEP Rules 706.07 clearly states:

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To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; Switching from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

The Examiner is requested to state for the record why he did not violate MPEP rule 706.07 , why he conducted a new search and why he raised new objections when the Applicant did not amend any claims.

Section §112, 2¶ Rejection

Examiner has asserted that the Applicant's claim language in Claim 1 and Claim 19 is indefinite under 35 USC §112, 2¶, specifically the step of "accepting a one-time permanent registration fee" is vague and indefinite. The Applicant traverses this assertion.

Section §112, 2¶ Response

Astonishingly, the Examiner has now asserted for the first time that the exact claim limitation of "accepting a one-time permanent registration fee" for a permanent registration of a domain name is vague and indefinite.

This is of the claim elements the Examiner admitted on Pages 6, 9, 11 and in the previous Office Action (December 5, 2005) that KORITZINSKY failed to teach. The Examiner specifically admitted that KORITZINSKY "failed to teach using the permanent registration fee to be added to a financial instrument who profit can be used to perpetually pay future renewal fees."

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It is also one of the claim elements that the Examiner has asserted in the present Office Action is taught by KORITZINSKY to make an obviousness rejection. In fact after making the §112 rejection, the Examiner on page 6 of the current Office Action asserts the critical issue is the "fee payment option and facing the problem of expiring service due to non-payment" and KORITZINSKY now inherently teaches this claim limitation to further bolster his obviousness rejection.

This rejection is very suspicious to the Applicant as self-serving by the Examiner to manufacture a §112 rejection so the Applicant is forced to amend Claim 1 to further fit the claim language into the obvious rejection being manufactured by the Examiner.

The Applicant declines to amend the Claims and submits the claim language as filed is clear and definite as filed and as examined without rejection in the previous office action by the Examiner. The Applicant will point out this suspicious rejection to the Appeals Board.

First Section 103 Rejection

Claims 1-3, 9, 12-13, 14-18, 19-20, 23-24, 25-29 30-31 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable of AAPA in view of KORITZINSKY (U.S. Patent No. 6,272,469).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

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First Section 103 Response

CLAIM 1:

The Examiner asserts that Claim 1 is rejected over "Applicant Admitted Prior Art (AAPA)." The Examiner asserts that the Applicant's invention, specifically all the elements of Claim 1 are admitted in the Background Section of the Application on pages 1-4. The Applicant traverses this assertion.

The Background section of the Applicant's application on pages 1-4 does not teach, suggest or even mention the claim limitations, including, but not limited to, a permanent registration certificate, a permanent domain name registration system, accepting a one-time permanent registration fee to perpetually pay all future renewal fees and issuing a permanent registration certificate.

The Examiner is reminded that to establish *prima facie* obviousness of a claimed invention in the first place, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (CCPA 1974).

The Applicant now demands the Examiner state for the record where he finds each and every claim term from Claim 1 in the Background section of the Applicant's application to establish a *prima facie* case of obviousness in the first place based on the holdings of *In re Royka.*

The Examiner then on Page 4 of his current office action asserts the Claim 1 reads over a new claim including words made up by the Examiner himself. This claim was not filed by the Applicant and is not included anywhere in the Applicant's application. The Examiner changes words in the Applicant's original claim 1 and adds self-serving allegedly equivalent words of his own not filed by the Applicant.

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The Examiner inserts several words including "service," "subscription service," and others in the claim he has written himself.

The Examiner then absurdly asserts, that the claim he wrote himself with words he selected himself, was admitted by the Applicant's application and makes the Applicant's Claim 1 obvious over the Applicant's application itself. The Applicant traverses this assertion as the Examiner's words are not the words included in the claims as filed by the Applicant.

The Applicant's attorney has never, in his eleven years as patent attorney seen a more bizarre attempt by an Examiner to reject the claims in an application.

The Examiner is reminded that is his job to examine applications written by Applicant's under MPEP Rule 706 not write new claims for the Applicant and then claim they are obvious based on words the Examiner chooses. Such an exercise is clearly inappropriate and clearly not within the scope of the Examiner's duties.

Even after adding the word service and subscription to the claim formulated by the Examiner, the Examiner admits one more time that the Applicant's application does not teach "a one-time permanent registration fee which would result in an issuing of a permanent registration certificate" (Page 5, current office action)

The Examiner then goes onto to admit that KORITINSKY teaches another type of subscription service for renewing licenses for computer software programs used to analyze medical images (but not the permanent subscription service for domain names claimed by the Applicant) (Page 6, current office action).

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By the Examiner's own words and admissions not all of the claim limitations have been taught by the Applicant's application alone or in combination with KORITZINSKY.

The Examiner has thus clearly not established a *prima facie* case of obviousness for the claimed invention in violation of the holdings of *In re Royka*. Thus, Claim 1 is not obvious and the Section 103 rejection should be immediately withdrawn.

The Applicant need not respond any further. However, for completeness the Applicant responds as follows.

The Examiner is appearing to rely on words he selected for the claims he wrote himself and the teachings of KORITZINSKY being equivalent to that of the Applicant. The Examiner is reminded that in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and **cannot be based on applicant's disclosure** or the mere fact that the components at issue could be functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958) (or based on words the Examiner makes up himself).

The Applicant now demands that the Examiner provide evidence of such equivalence from the prior art supporting the assertion that a subscription service for software to view medical images is the same as the permanent registration service for domain names claimed by the Applicant. The Examiner has not provided any such equivalency evidence from the prior art at all required under the holding of *In re Ruff*.

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The Examiner then admits once again that the subscription service in KORITZINSKY deals with subscribing to a diagnostic system/service for software licenses.

The Examiner then conveniently asserts that "the type of subscription service is not critical" and "as for the difference in the type of subscription services, this not critical," to further bolster his arguments for obviousness without any proof whatsoever.

The Examiner has provided no evidence of any kind for conveniently saying the type of subscription service is "not critical" other than to bolster his obviousness rejection.

The Examiner is reminded it is never appropriate to rely solely on knowledge without evidentiary support in the record as the principal evidence upon which a rejection was based. See, *In re Zurko*, 258 F.3d 1379, 59 (Fed. Cir. 2001) and *In re Ahlert,* 424 F.2d 1088 (CCPA 1970).

The Applicant now demands the Examiner provide evidentiary support from the references cited by the Examiner, that is, the current record, that supports his assertion that "the type of subscription service is not critical" under the holdings of *In re Zurko* and *In re Ahlert.*

The Examiner then asserts the subscription service of KORITZINSKY reads over the claim limitation of a "one time permanent registration fee used to perpetually pay all future renewal fees for the domain name registration" and is inherently included in the teachings of KORITZINSKY. The Applicant traverses this assertion.

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Not only did the Examiner admit several times in two Office actions that KORTIZINSKY did not teach this claimed feature, the Examiner has not provided any proof of inherency. The Examiner also made assertions with no proof whatsoever that certain things taught by KORITZINSKY were not critical without any proof and then immediately jumps to equivalence by inherency.

The Examiner is reminded that to establish inherency in the first place, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

The Examiner clearly has not met the burden of proof for inherency under In re Robertson. No person skilled in the art, when viewing the teachings of KORITZINSKY that teaches providing medical imaging system protocols for medical imaging system services and does not teach, suggest or even mention domain names, would inherently find a permanent domain name registration certificate or permanent domain name registration system or any of the other additional limitations described by the claimed invention.

The Applicant requests the Examiner provide extrinsic evidence that makes clear that the missing descriptive matter is necessarily present in the cited claim elements claimed by the Applicant could exist in KORITZINSKY that someone skilled in the art would agree with.

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The Examiner is also reminded that obviousness can only established by combining the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); In re Jones, 958 F.2d 347 (Fed. Cir. 1992). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no motivation to make the proposed modification. *In Re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). If a proposed modification or combination of the prior art would change the principle operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959).

One of the principal operations of KORITZINSKY, is to provide a novel approach to handling imaging and diagnostic system protocols. The technique is employed on centralized management stations, such as a station linking several scanners in a radiology department of a medical institution. (Col. 2, lines 39-66). No radiology of a medical institution would have any interest in providing a permanent domain name registration system as claimed by the Applicant. Trying the combine the Applicant's invention with KORITZINSKY, renders KORITZINSKY unsatisfactory for one of its intended purposes and changes its principal operation, namely, allowing a radiologist to view medical images to make health diagnosis on patients. Trying to combine the Applicant's invention with KORITZINSKY may endanger the health of patients of a medical institution and would constitute an improper use of the scanners and management stations in radiology department.

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Thus, there is clearly no motivation to combine the Applicant's Application and KORITZINSKY. Trying to do so violates the holdings of *In re Fine, In Re Gordon and In re Ratti.*

The Applicant has clearly shown why Claim 1 is not obvious over its own Application view of KORITZINSKY. The same arguments apply for independent claims 10, 16 and 20. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to independent Claims 1, 10, 16 and 20. Since these claims are not obvious they are all immediately allowable in there present form.

Dependent Claims 2, 3, 9, 12-15, 17-19, 23-24, 25-29, 30-31 and 32-33

The Examiner is reminded that if an independent claim is non-obvious under 35 USC 103, then any claim depending there from is non-obvious *In re Fine* 837 F.2d 1071 (Fed. Cir. 1988).

All of arguments for Claim 1 are incorporated by reference. All of the dependent claims add additional limitations not present the independent claims. The Applicant has clearly pointed out why the independent claims not obvious. Thus, the dependent claims are not obvious either under the holding of In re Fine.

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Second Section 103 Rejection

Claims 6-8, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of KORITZINSKY (U.S. Patent No. 6,272,469) in view of Cummings (U.S. Patent No. 6,470,321).

The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

Second Section 103 Response

All of the arguments for Claim 1 above are incorporated by reference for Claims 4-5 and further apply in view of Cummings. The combination of these three references still does not teach or suggest the claimed invention claimed by Claims 4-5 either alone or in combination thereof.

Thus, Claims 4-5 are not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 4-5 in view of Cummings. Since these claims are not obvious they should all be immediately allowable in its present form.

Third Section 103 Rejection

Claims 6-8, 10-11 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claims 6-8, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of KORITZINSKY (U.S. Patent No. 6,272,469) in view of Burnstein (U.S. Patent No. 7,076,541).

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The Applicant traverses all of the Examiner's assertions. The Applicant may respond to selected assertions by the Examiner, but the Applicant intends to traverse all of the Examiner's assertions. The Applicant accepts all of the Examiner's admissions.

Third Section 103 Response

All of the arguments for Claim 1 above are incorporated by reference for Claims 6-8, 10-11 and 21-22 and further apply in view of Burnstein. The combination of these three references still does not teach or suggest the claimed invention claimed by Claims 6-8, 10-11 and 21-22 either alone or in combination thereof.

Thus, Claims 6-8, 10-11 and 21-22 are not obvious. Therefore, the Applicant now requests the Examiner immediately withdraw the §103 rejections with respect to Claims 6-8, 10-11 and 21-22 in view of Cummings. Since these claims are not obvious they should all be immediately allowable in its present form.

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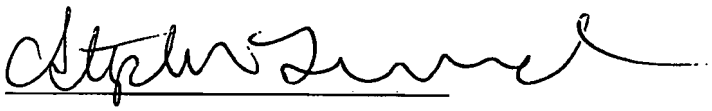
CONCLUSION

The prior art made of record in the Office Action but not relied upon by the Examiner is no more pertinent to Applicant's invention than the cited references for the reasons given above. The Applicant therefore submits that all of the claims in their present form are immediately allowable and requests the Examiner withdraw the §112 rejection and all the §103 rejections of claims 1-33 and pass all of the claims immediately to allowance.

Respectfully submitted.

Lesavich High-Tech Law Group, PC (32097)



Dated: February 13, 2 007

Stephen Lesavich, PhD

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,408	06/07/2001	Charles P. Brown	00,464-A	7316

32097 7590 05/18/2007

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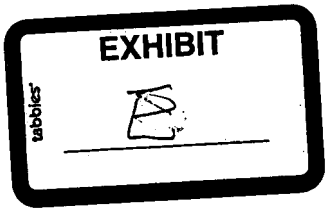
EXAMINER	
NGUYEN, TAN D	
ART UNIT	**PAPER NUMBER**
3629	
MAIL DATE	**DELIVERY MODE**
05/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



Office Action Summary	Application No.	Applicant(s)	
	09/876,408	BROWN, CHARLES P.	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 2-14, filed Feb. 13, 2007, with respect to the previous 112, 2nd and 103 rejections have been fully considered and are not persuasive since they are merely applicant's allegations, see paragraphs 11-13 below.

Claims 1-33 are pending and rejected as followed.

Claim Rejections - 35 USC § 112

2. Claims 1-13, 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 5, the 2nd step of "accepting a one-time permanent registration fee" is vague and indefinite. From the specification, it appears this phrase appears to mean "accepting a one-time permanent registration fee payment" and therefore, insertion of the term "payment" after "fee" is recommended to improve clarity.

Similarly, claims 19-24, are rejected for the same reasons set forth in claims 1-13 above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-3, 9, 12-13, 14-18, 19-20, 23-24, 25-29, 30-31, 32-33, which are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of KORITZINSKY et al.

Claim 1 is as followed:

1. A method for protecting domain name registrations with a permanent registration certificate, comprising:

accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;

accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; and

issuing a permanent registration certificate for the domain name registration based on the accepted information, wherein the permanent registration certificate provides a

permanent registration the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

Claim 1 reads over:

A method for protecting a subscription service with a permanent service certificate wherein the service is domain name registrations subscription, comprising:

accepting information associated with a subscription service, wherein the subscription service is domain name registration obtained from a public domain name registrar on a domain name registration system;

accepting a one-time permanent registration fee for the subscription service wherein the subscription service is domain name registration, on a permanent subscription service system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the subscription service; and

issuing a permanent service certificate based on the accepted information, wherein the subscription service is domain name registration, and the permanent service certificate is about domain name registration and the certificate provides a permanent registration the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

As shown under the "Background of the Invention" in the specification, the domain name registration basically is subscription **service** that identifies and protect the IP addresses to make it easier for people to identify the sites on the Internet. Every year, each subscriber has to pay $35.00/year for the maintaining of the service {see page 4, last paragraph}.

Similarly, as indicated in the specification, under "Background of the Invention", **AAPA** fairly discloses a method for domain name registrations service with a annual registration receipt (certificate), comprising:

(a) accepting information associated with a domain name registration (subscription service) obtained from a public domain name registrar on a domain name registration system {see page 3, last two paragraphs};

(b) accepting a yearly (annual) payment of registration fee for the domain name registration (subscription service) on the annual domain name registration system {see page 4, last paragraph}; and

(b) issuing an annual registration certificate (receipt) for the domain name registration based on the accepted information {see pages 4-6, see "a domain name can registered electronically at nsi.com" on page 3, line 19-21}.

AAPA fairly teaches the claimed invention except for the type of fee payment for subscription (registration) service from annual payment ($35.00/year) to a one-time permanent registration fee with would result in an issuing of a permanent registration certificate (receipt) in step (c.), for example a payment of $3,500 to cover 100 years or $1,000,000 for perpetually permanent service).

In another subscription service, KORITZINSKY et al discloses several types of fee payment options (financial management arrangements) that may be provided to the subscriber for different levels of service, such as (a) pay-per-use, (b) periodically (yearly), or (c.) permanently, such as lifetime or non-expiring warranty service {see col. 21, lines 15-50}. In view of the general problems with respect to the expired subscribed service for the domain name registration as mentioned in the AAPA , it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the benefit of lifetime or non-expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service, however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is "fee payment option" and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service.
As for the limitation of "wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration", this reads over the limitation "lifetime or non-expiring warranty service" of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.

As for the limitation of a certificate, this reads over the term "receipt of the service request" as shown in col. 21, line 24-26. As for the limitation "a permanent registration certificate", this is taught in AAPA / KORITZINSKY et al when "life time" service is selected/requested and the receipt of the service requested would inherently include the "permanent service".

6. As for dep. claim 2 (part of 1 above), which deals with well known computer readable medium having stored therein instructions for causing a processor to execute the steps of method claim 1, this is inherently included in the online system of AAPA /KORITZINSKY et al.

7. As for dep. claims 3, 9 (part of 1 above), which deals with well known information displaying parameters, i.e. certificate or receipt of fee payment for service, this is fairly taught in Fig. 1, Fig. 15, Fig. 8, "212", "PROBLEM DESCRIPTION".

8. As for dep. claims 12-13 (part of 1 above), which deals with well known payment parameters, i.e. electronically or manually, these are inherently included in the registration over the Internet as taught in AAPA. Alternatively, the manual payment of fee by mail or other would have been obvious because this is well known practice.

As for method claims 14-18, 19-20, 23-24, 25-29, 30-31, 32-33, which basically have the same limitations as in claims 1-3, 9, 12-13 above, they are rejected for the same reasons set forth above.

9. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA /KORITZINSKY et al as applied to claims 1-3, 9, 12-13, above, and further in view of MANN et al and CUMMINGS et al .

As for dep. claims 4-5 (part of 1 above), the teachings of AAPA /KORITZINSKY et al is cited above. MANN et al, as shown on col. 2, lines 4-18, is cited to disclose well known facts that many domain names have been registered by sellers/brokers as assets (equity) which may be sold for large sums of money for acquiring or transferring and using of the domain names to point to their content sources.

CUMMINGS et al is cited to teach well known business practice of obtaining insurance policy and title for an equity /asset to cover financial losses associated with the equity, thus protecting the equity/asset investment in case of losses {see col. 1, lines 15-20, claim 1}. It would have been obvious to modify the teachings of AAPA /KORITZINSKY et al by obtaining insurance policy and title as taught by CUMMINGS et al for the domain name registration to protect the domain names since MANN et al discloses that domain names are valuable assets/equity that can be sold for large sums of money.

10. Claims 6-8, 10-11, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA /KORITZINSKY et al as applied to claims 1-3, 9, 12-13, 19-20 above, and further in view of BURSTEIN et al.

As for dep. claims 6-8, 10-11 (part of 1 above) and 21-22 (part of 19 above), the teachings of AAPA /KORITZINSKY et al is cited above. BURSTEIN et al is cited to teach well known facts that many domain names have been registered by

sellers/brokers as assets (equity) which may be sold for large sums of money for acquiring or transferring and using of the domain names and many cases, the registrant may incorporate one or more domain names into an organization identity or business {see col. 2, lines 40-50}. As for dep. claims 6-8 and 10-11, which deal with well known business parameters for carrying out a business or corporation such as issuing shares, issuing leases or sub-leases of an asset, etc., and the practices of these business parameters in the teachings of AAPA /KORITZINSKY et al would have been obvious as routine business parameters.

Response to Arguments

11. Applicant's arguments filed 2/13/2007 have been fully considered but they are not persuasive since they are merely applicant's opinions/allegations.

In response to applicant's argument that AAPA and KORITZINSKY et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, In view of the general problems with respect to the expired subscribed service for the domain name registration as mentioned in the AAPA , it would have been obvious to modify the yearly/annual fee payment teachings of AAPA with a permanent fee payment as taught by KORITZINSKY et al to obtain the benefit of lifetime or non-expiring warranty service. Note that the type of subscription service in KORITZINSKY et al deals with subscribing to diagnostic system/service,

however, the type of service or subscription service is not critical since fee payment arrangement can be applied in any subscription service. Moreover, the critical issue is "fee payment option" and facing with the problem of expiring of service due to non-payment, a skilled artisan would look to the teachings of fee payment options or different levels of service and if the service is so critical while the fee payment is so cheap, one would pick the permanent or lifetime or non-expiring warranty service to insure lifetime service. As for the difference in the type of subscription services, again, this is not critical and within the skill of the artisan since the major issue is the types of fee payment options for different levels of service and subscription to diagnostic service is one of many teachings cited by KORITZINSKY et al.

As for the limitation of "wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration", this reads over the limitation "lifetime or non-expiring warranty service" of KORITZINSKY et al and is therefore inherently included in the teachings of KORITZINSKY et al above.

12. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

13. As for the request of the examiner to list the reason why the Examiner has violated MPEP rule 706.07 cited by the applicant on page 4 of the response of 2/13/07, there are two issues:

(1) the examiner requested the applicant to cite where in the MPEP rule 706.07 with respect to the specific citation by the applicant ..."To bring the prosecution ...or a final rejection", the examiner has a hard time finding this citation/argument, and

(2) the examiner has made the 2nd non-final rejections of 8/25/06 for the reason stated above, see paragraphs no. 5-10.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claims are allowed.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see http://pair-direct@uspto.gov. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov .

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss can be reached at (571) 272-6812.

The main FAX phone numbers for formal communications concerning this application are **(571) 273-8300**. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
May 14, 2007

DEAN T. NGUYEN
PRIMARY EXAMINER

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(54) METHOD AND SYSTEM FOR PROTECTING DOMAIN NAMES

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(22) Filed: Jun. 7, 2001

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Publication Classification

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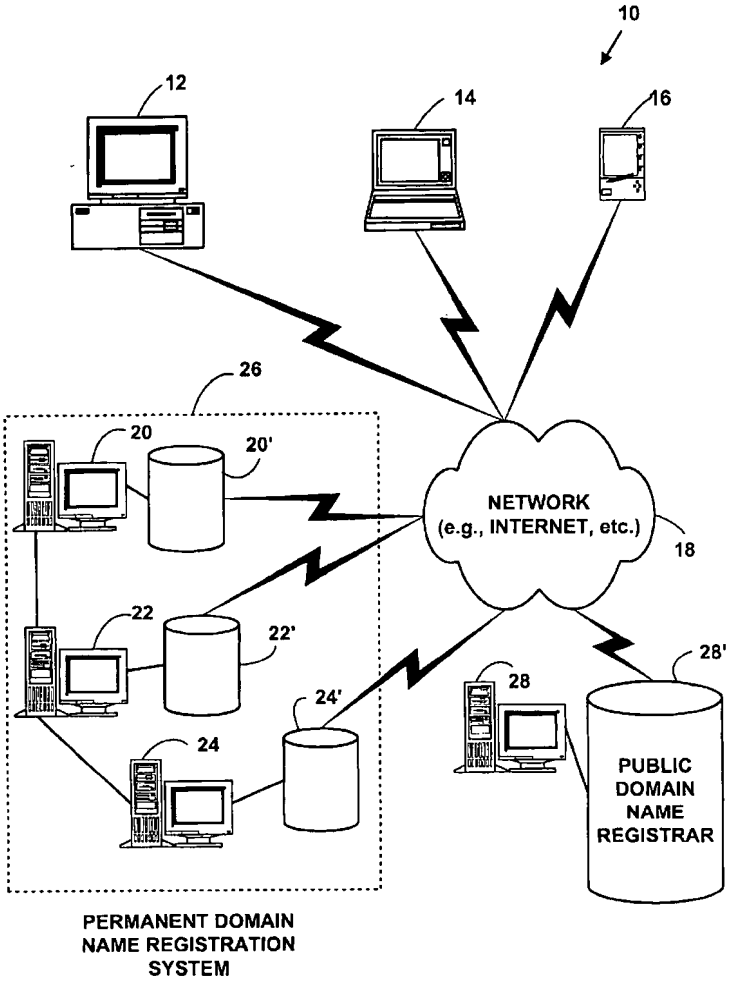
(52) U.S. Cl. 709/245; 709/223

(57) ABSTRACT

A method and system for protecting domain names. A permanent registration certificate for providing a permanent registration of a domain name can be issued. The permanent registration certificate provides a permanent registration of a domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar. A permanent web-site accessible via the Internet and associated with a domain name registration from an issued permanent registration certificate is perpetually hosted. The method and system help prevent a domain name owner from ever losing valuable domain name rights, reduce the burden and administrative overhead placed on domain name owners and more fully utilize existing and new rights associated with a domain name registration.



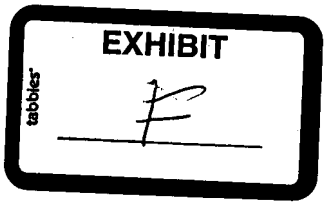


FIG. 1

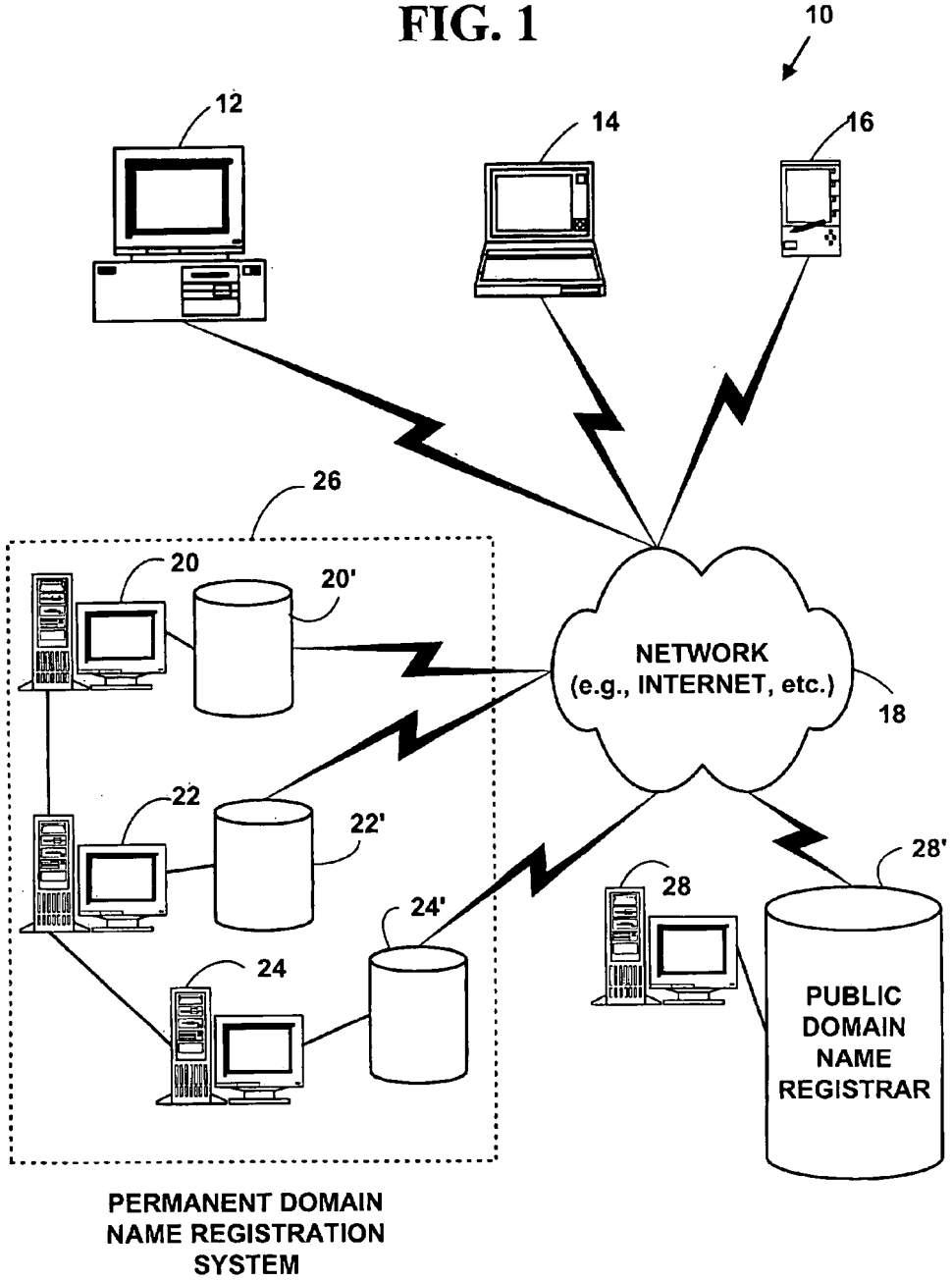

10
12
14
16
26
20
20'
NETWORK
(e.g., INTERNET, etc.)
18
22
22'
24'
24
28
28'
PUBLIC
DOMAIN
NAME
REGISTRAR
PERMANENT DOMAIN
NAME REGISTRATION
SYSTEM

FIG. 2

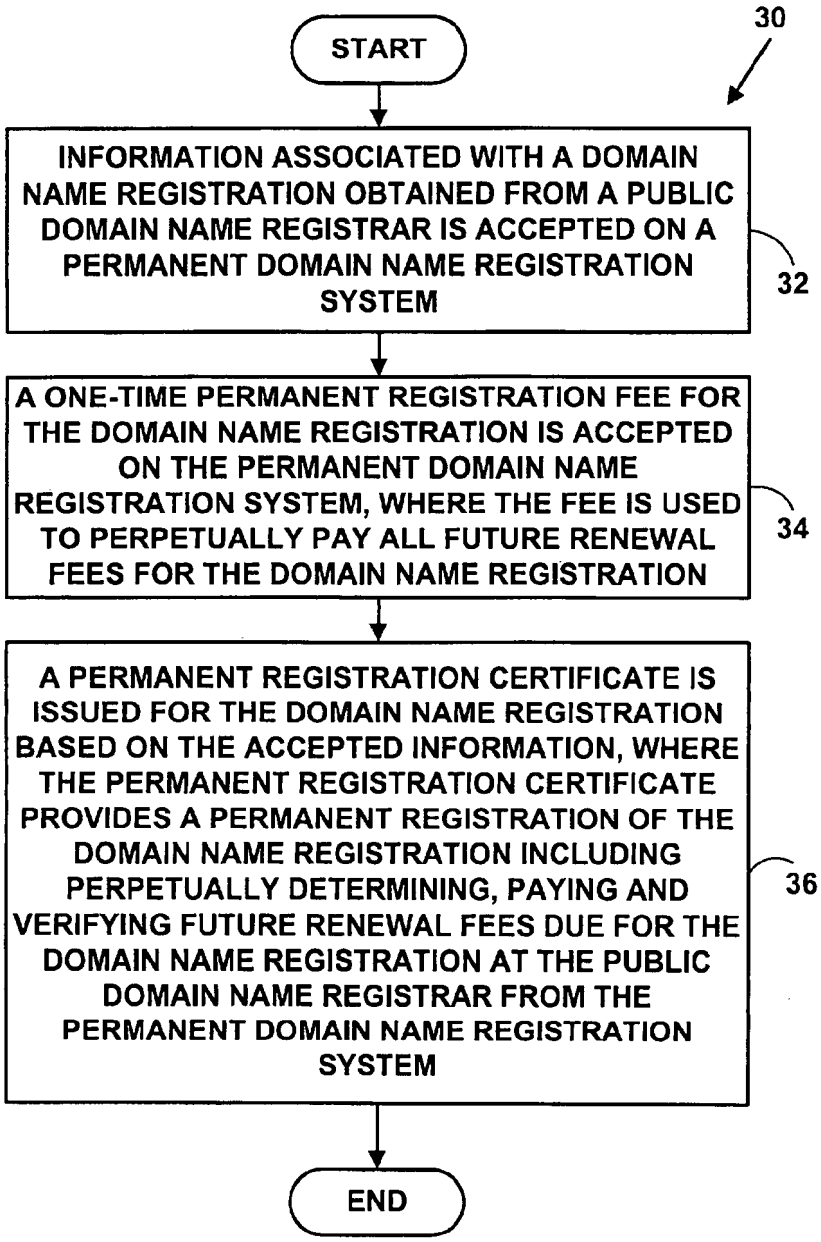

START
30
INFORMATION ASSOCIATED WITH A DOMAIN NAME REGISTRATION OBTAINED FROM A PUBLIC DOMAIN NAME REGISTRAR IS ACCEPTED ON A PERMANENT DOMAIN NAME REGISTRATION SYSTEM
32
A ONE-TIME PERMANENT REGISTRATION FEE FOR THE DOMAIN NAME REGISTRATION IS ACCEPTED ON THE PERMANENT DOMAIN NAME REGISTRATION SYSTEM, WHERE THE FEE IS USED TO PERPETUALLY PAY ALL FUTURE RENEWAL FEES FOR THE DOMAIN NAME REGISTRATION
34
A PERMANENT REGISTRATION CERTIFICATE IS ISSUED FOR THE DOMAIN NAME REGISTRATION BASED ON THE ACCEPTED INFORMATION, WHERE THE PERMANENT REGISTRATION CERTIFICATE PROVIDES A PERMANENT REGISTRATION OF THE DOMAIN NAME REGISTRATION INCLUDING PERPETUALLY DETERMINING, PAYING AND VERIFYING FUTURE RENEWAL FEES DUE FOR THE DOMAIN NAME REGISTRATION AT THE PUBLIC DOMAIN NAME REGISTRAR FROM THE PERMANENT DOMAIN NAME REGISTRATION SYSTEM
36
END

FIG. 3A

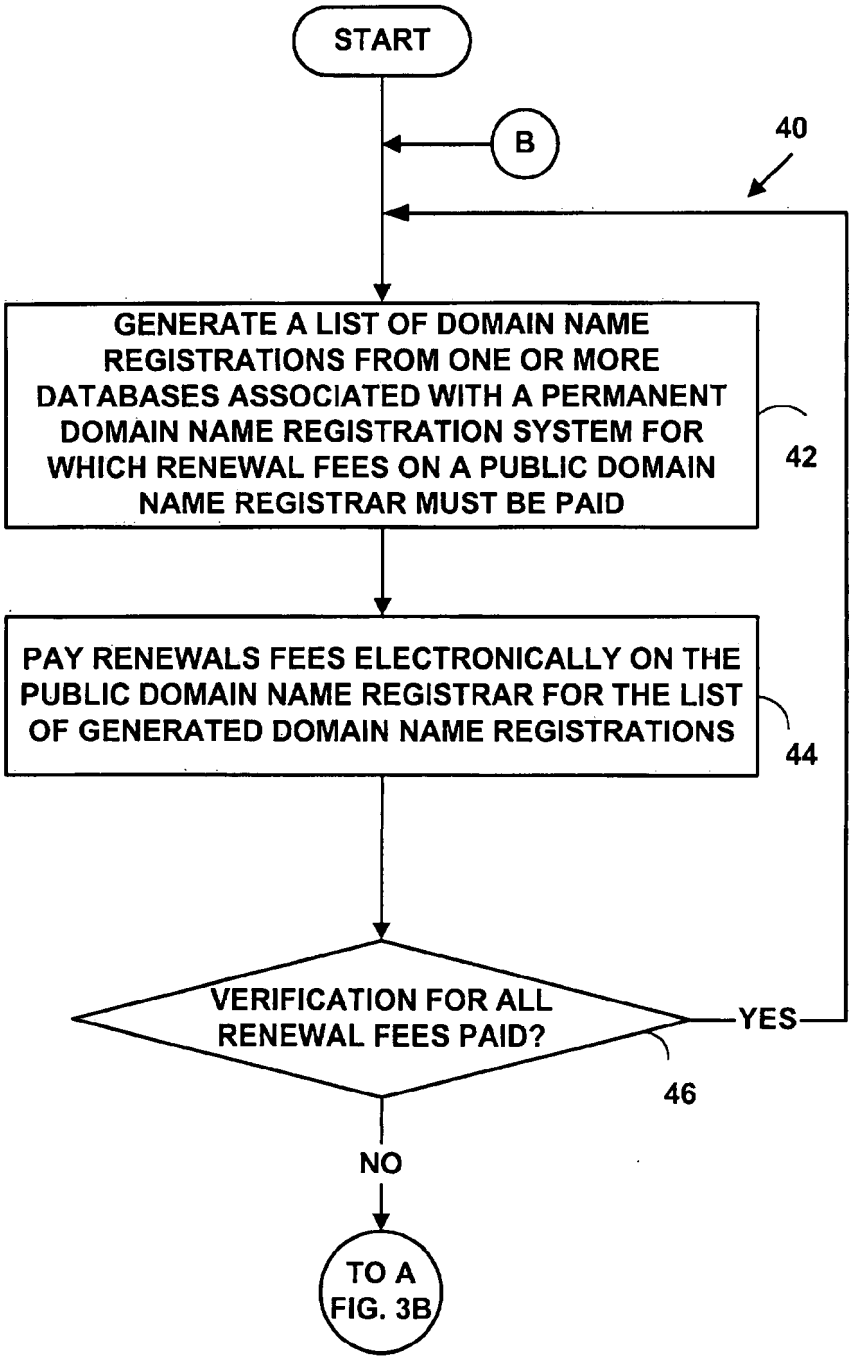

START
B
40
GENERATE A LIST OF DOMAIN NAME REGISTRATIONS FROM ONE OR MORE DATABASES ASSOCIATED WITH A PERMANENT DOMAIN NAME REGISTRATION SYSTEM FOR WHICH RENEWAL FEES ON A PUBLIC DOMAIN NAME REGISTRAR MUST BE PAID
42
PAY RENEWALS FEES ELECTRONICALLY ON THE PUBLIC DOMAIN NAME REGISTRAR FOR THE LIST OF GENERATED DOMAIN NAME REGISTRATIONS
44
VERIFICATION FOR ALL RENEWAL FEES PAID?
YES
46
NO
TO A FIG. 3B

FIG. 3B

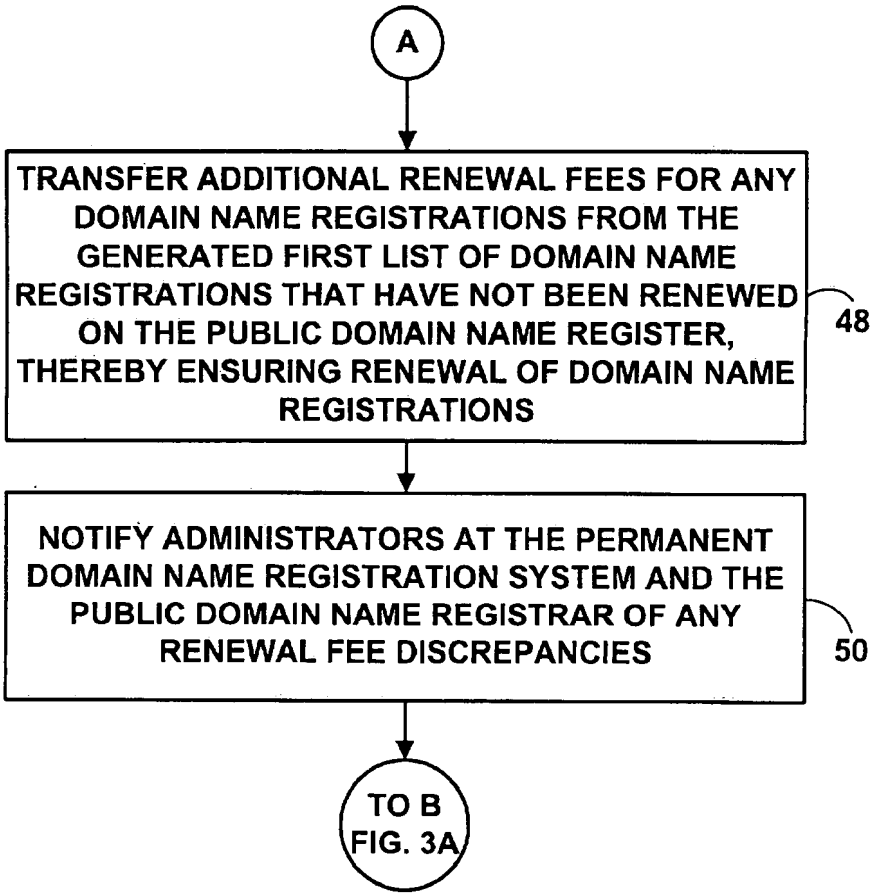

A
TRANSFER ADDITIONAL RENEWAL FEES FOR ANY DOMAIN NAME REGISTRATIONS FROM THE GENERATED FIRST LIST OF DOMAIN NAME REGISTRATIONS THAT HAVE NOT BEEN RENEWED ON THE PUBLIC DOMAIN NAME REGISTER, THEREBY ENSURING RENEWAL OF DOMAIN NAME REGISTRATIONS
48
NOTIFY ADMINISTRATORS AT THE PERMANENT DOMAIN NAME REGISTRATION SYSTEM AND THE PUBLIC DOMAIN NAME REGISTRAR OF ANY RENEWAL FEE DISCREPANCIES
50
TO B FIG. 3A

FIG. 4

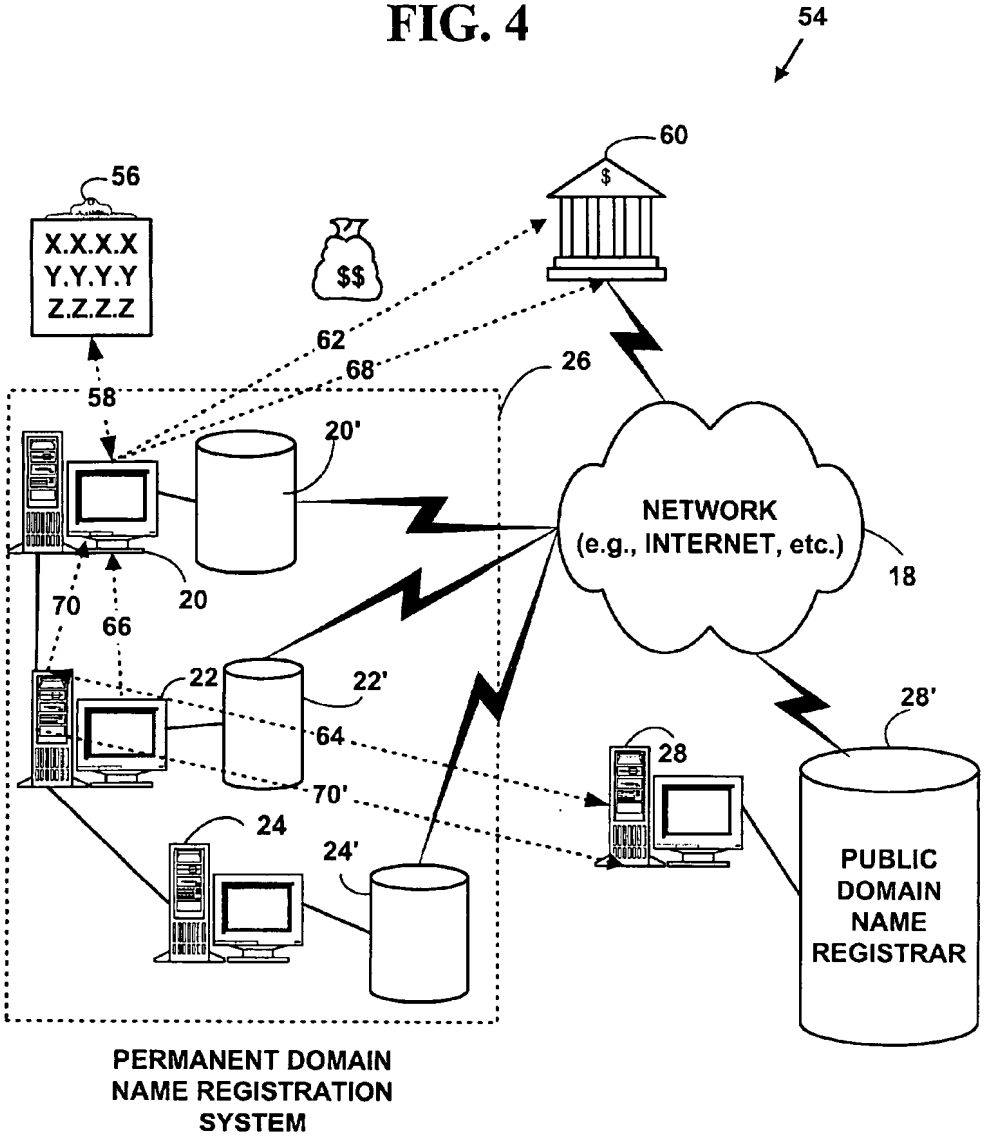

54
60
56
X.X.X.X
Y.Y.Y.Y
Z.Z.Z.Z
$$
62
68
26
58
20'
NETWORK
(e.g., INTERNET, etc.)
18
70
66
20
22
22'
64
28'
28
70'
24
24'
PUBLIC
DOMAIN
NAME
REGISTRAR
PERMANENT DOMAIN
NAME REGISTRATION
SYSTEM

FIG. 5

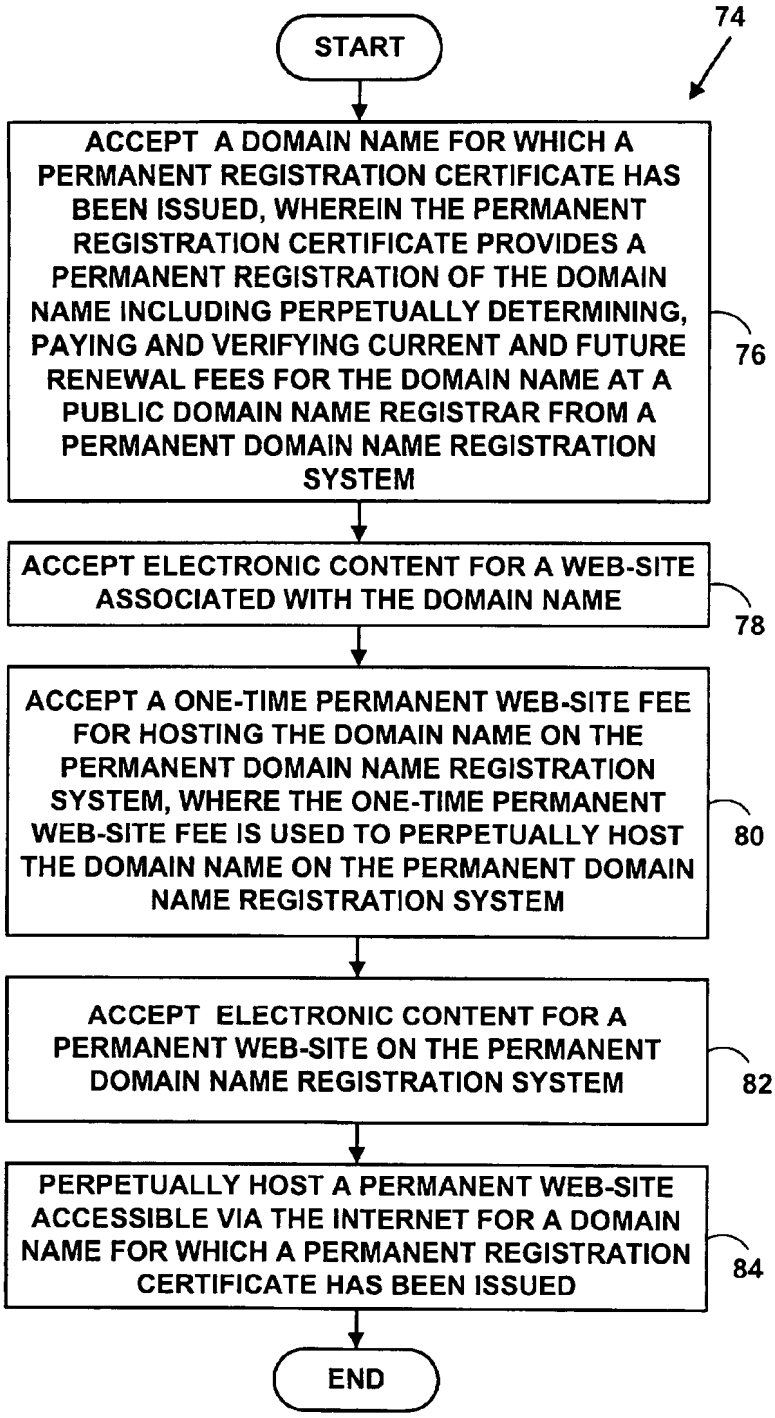
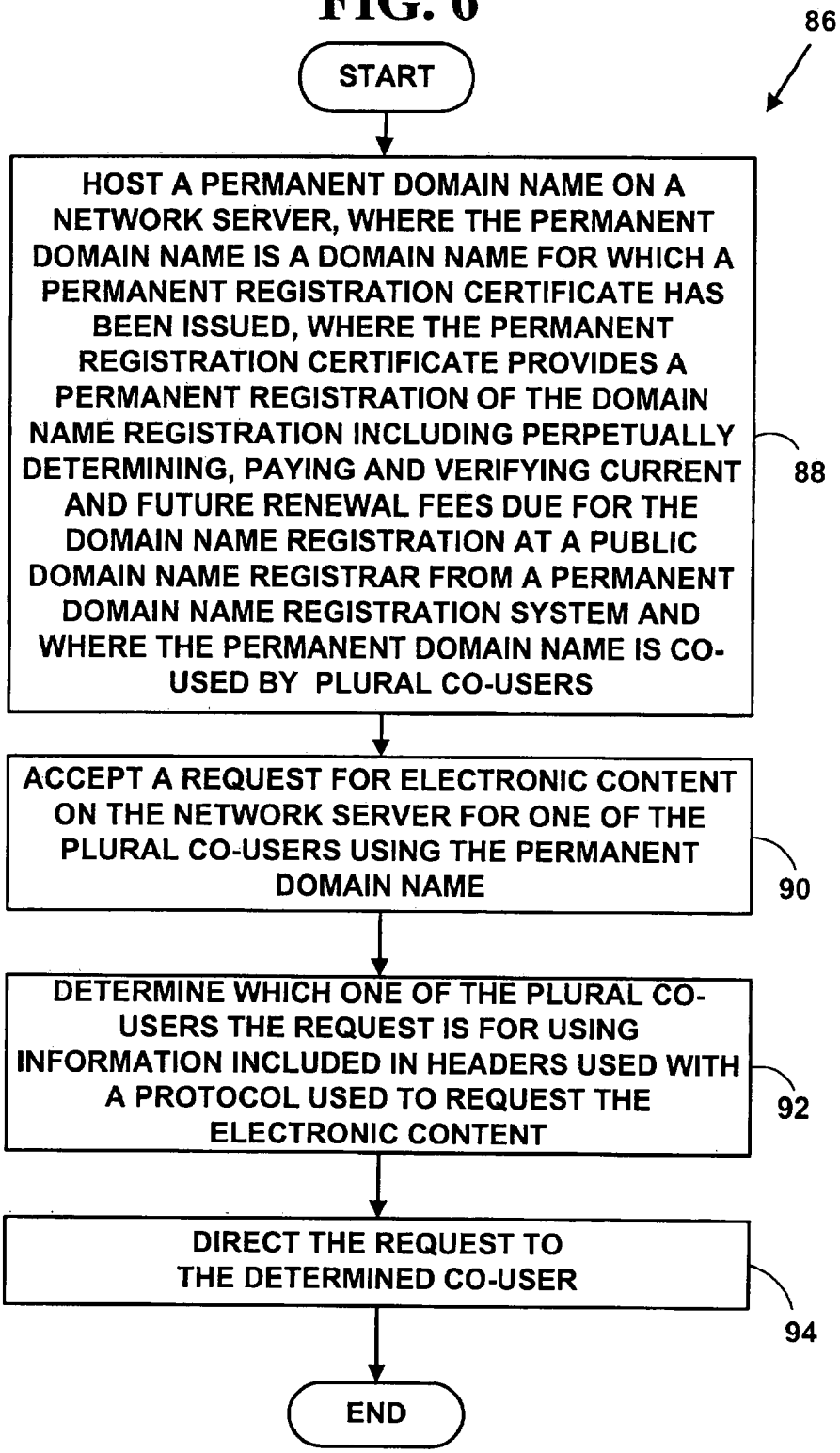

74
START
ACCEPT A DOMAIN NAME FOR WHICH A PERMANENT REGISTRATION CERTIFICATE HAS BEEN ISSUED, WHEREIN THE PERMANENT REGISTRATION CERTIFICATE PROVIDES A PERMANENT REGISTRATION OF THE DOMAIN NAME INCLUDING PERPETUALLY DETERMINING, PAYING AND VERIFYING CURRENT AND FUTURE RENEWAL FEES FOR THE DOMAIN NAME AT A PUBLIC DOMAIN NAME REGISTRAR FROM A PERMANENT DOMAIN NAME REGISTRATION SYSTEM
76
ACCEPT ELECTRONIC CONTENT FOR A WEB-SITE ASSOCIATED WITH THE DOMAIN NAME
78
ACCEPT A ONE-TIME PERMANENT WEB-SITE FEE FOR HOSTING THE DOMAIN NAME ON THE PERMANENT DOMAIN NAME REGISTRATION SYSTEM, WHERE THE ONE-TIME PERMANENT WEB-SITE FEE IS USED TO PERPETUALLY HOST THE DOMAIN NAME ON THE PERMANENT DOMAIN NAME REGISTRATION SYSTEM
80
ACCEPT ELECTRONIC CONTENT FOR A PERMANENT WEB-SITE ON THE PERMANENT DOMAIN NAME REGISTRATION SYSTEM
82
PERPETUALLY HOST A PERMANENT WEB-SITE ACCESSIBLE VIA THE INTERNET FOR A DOMAIN NAME FOR WHICH A PERMANENT REGISTRATION CERTIFICATE HAS BEEN ISSUED
84
END

FIG. 6


86
START
HOST A PERMANENT DOMAIN NAME ON A NETWORK SERVER, WHERE THE PERMANENT DOMAIN NAME IS A DOMAIN NAME FOR WHICH A PERMANENT REGISTRATION CERTIFICATE HAS BEEN ISSUED, WHERE THE PERMANENT REGISTRATION CERTIFICATE PROVIDES A PERMANENT REGISTRATION OF THE DOMAIN NAME REGISTRATION INCLUDING PERPETUALLY DETERMINING, PAYING AND VERIFYING CURRENT AND FUTURE RENEWAL FEES DUE FOR THE DOMAIN NAME REGISTRATION AT A PUBLIC DOMAIN NAME REGISTRAR FROM A PERMANENT DOMAIN NAME REGISTRATION SYSTEM AND WHERE THE PERMANENT DOMAIN NAME IS CO-USED BY PLURAL CO-USERS
88
ACCEPT A REQUEST FOR ELECTRONIC CONTENT ON THE NETWORK SERVER FOR ONE OF THE PLURAL CO-USERS USING THE PERMANENT DOMAIN NAME
90
DETERMINE WHICH ONE OF THE PLURAL CO-USERS THE REQUEST IS FOR USING INFORMATION INCLUDED IN HEADERS USED WITH A PROTOCOL USED TO REQUEST THE ELECTRONIC CONTENT
92
DIRECT THE REQUEST TO THE DETERMINED CO-USER
94
END

METHOD AND SYSTEM FOR PROTECTING DOMAIN NAMES

CROSS REFERENCES TO RELATED APPLICATIONS

[0001] This Utility Application claims priority from U.S. Provisional Application No. 60/210,660, filed Jun. 9, 2000.

FIELD OF THE INVENTION

[0002] This invention relates to domain name identifiers used on a computer network. More specifically it relates to a method and system for protecting domain name identifiers.

BACKGROUND OF THE INVENTION

[0003] A domain name is a textual name that identifies one or more Internet Protocol ("IP") addresses on a computer network like the Internet, an intranet or other computer network. As is known in the art, IP is a routing protocol designed to route traffic within a network or between networks. An IP address is issued in the format X.X.X.X, where each X represents a number between zero and 255. For example an IP address for of 128.132.103.43 may be issued for a network server.

[0004] The domain name "chuckbrown.net" may identify the IP addresses 139.142.203.45 and 139.142.203.46. Domain names make it easier for people to identify sites on the Internet and other computer networks. If a textual domain name is not used, then a person would have to remember or memorize many different IP addresses to locate sites or information on the Internet or other computer networks.

[0005] Domain names are used by people in Uniform Resource Locators ("URLs") to identify particular web-sites on the Internet or other computer networks. Since sites on the Internet and other computer networks are identified by IP addresses and not domain names, web servers typically require assistance from a Domain Name Servers ("DNS") to translate domain names into IP addresses.

[0006] A domain name has a suffix that indicates which top-level domain ("TLD") it belongs to. There are only a limited number of TLDs including: (1) ".com," for commercial business; (2) ".edu," for educational institutions; (3) ".gov," for government agencies; (4) ".mil," for the military; (5) ".net," for network organizations and (6) ".org," for organizations including non-profit organizations. There have been recent proposals to add new TLDs including ".biz," for businesses, "firm," for professional organizations such as law firms, accounting firms, and others.

[0007] Network Solutions, Inc. ("NSI") under contract with the National Science Foundation was the exclusive registrar of TLD's from 1993-1998. The Internet Corporation for Assigned Names and Numbers ("ICANN") was established in 1998 to move the administration of the DNS to the private sector. There are now many different approved organizations that can register domain names in association with ICANN. For example, a domain name can be registered electronically at nsi.com, register.com, namedroppers.com, domainnameregistration.com, budgetregister.com and other web-sites on the Internet.

[0008] There are a number of problems associated with the current system of registering domain names. One problem is that the current system of registration fees for Global TLDs is designed to ensure that there is money available each year from each domain to contribute to the support of the registry/registrar system and the DNS. To achieve the purpose of ensuring funding and that each domain contributes to the system each year. This system establishes a monetary self-sufficiency for the registration system, but at the cost of administrative overhead and business risk for the users of the system.

[0009] Another problem is that the pre-eminence of the dot-com (".com)" TLD has created a de facto single global jurisdiction for trademark use. Instead of traditional common law trademark rights, which allows separate rights based on geographical separation, legitimate trademark holders can be restricted from using their trademark in the dot-com domain because someone else got it first or because another party with a conflicting trademark claim has more money to fight any trademark dispute in the courts. There are no technical barriers to allow multiple common law trademark holders sharing a domain name, but there are barriers within the current system of domain registration with the all-or-nothing ownership of domain names.

[0010] Another problem is that the current system of Internet domain ownership does not confer ownership in the traditional sense of the word. What is now referred to as "domain name ownership" is really just a right to use a domain, provided that the registration fee is current. An entity that "owns" a domain name retains the right to use that domain name by paying the registration fee on time. Otherwise the usage rights to the domain name are forfeited and the domain name returns to the general pool of domain names available for anyone to register and acquire usage rights.

[0011] Another problem is that domain names have become valuable entities unto themselves, far out of proportion in value to the cost of an annual registration fee. Some domains have a commercial value of millions of dollars, but non-payment of a single $35 payment can result in the loss of valuable rights and will disconnect a web-site at a domain name address.

[0012] Another problem with the current system of renewing domain names is that it places a high administrative cost on domain name owners to track and issue small payments. Large corporations typically have many domain names with administrative and payment contacts spread throughout divisions and departments. This distributed rather than centralized control increases the chances of one or more domains could expire. In addition, individuals listed as administrative and payment contacts could leave an organization thereby preventing the proper individual to be timely located to handle problems with, or renewals of, domain names.

[0013] Another problem is that there is no system of accountability or defined procedures for the registrars to guarantee that the renewal notices for a domain are ever issued or received to ensure that the individuals responsible for the domain are notified. In the case of no response to a renewal notice, there are no procedural guarantees are in place to protect the rights of the domain name owner. There is also a lack of survivorship or beneficiary rights from the domain name registrars for individual domain name holders who die.

[0014] Another problem is the maintenance of domain rights beyond the term of currently paid registration fees.

The current domain name registration system currently sends renewal notices via electronic mail ("e-mail"). In today's society, individuals frequently change Internet Service Providers, and hence frequently change e-mail addresses. In addition, even business organizations may change e-mail addresses due to mergers, acquisitions, buy-outs, re-organizations, bankruptcy, etc. If a domain name owner changes e-mail addresses between registration periods, the possibility exists that the domain name payment notice will not be received, increasing the possibility of the registration period lapsing.

[0015] Another problem is that Internet Service Providers ("ISP") and other organizations that host web-sites associated with a domain name frequently go out of business. Many domain name owners would like the ability to maintain a permanent web-site on the Internet without regard to the underlying web-site host.

[0016] Another problem is that under the current system of domain rights, domain ownership or access rights exist on an all-or-nothing basis. The named registrant has all rights to the use of the domain name and any web or e-mail address that is in that domain. Therefore, there is limited opportunity to take advantage of additional possible uses of domain name registrations.

[0017] Another problem is that under the current system of investment in domain names, domain registrants offer domains for sale either directly or through domain reseller web sites such as GreatDomains.com or Afternic.com. These sites handle thousands of sales, but all sales are for a full interest in the domain and require a transfer of the domain from the investor to the new registrant. The current system defines an inefficient market based on an all-or-nothing ownership structure that does not allow ownership interests in domain names to be shared by multiple parties.

[0018] Another problem is the danger of hacking or tampering or errors at the registrar or registry level. Domain names have been hacked or hijacked from legitimate owners. Even when the domain names can be recovered, substantial fees including legal fees can be incurred by the legitimate owner.

[0019] Thus, it is desirable to provide a method to permanently protect and utilize domain name registrations. The method should help prevent a domain name owner from ever losing valuable domain name rights and fully utilize existing and new rights associated with a domain name registration.

SUMMARY OF THE INVENTION

[0020] In accordance with preferred embodiments of the present invention, some of the problems associated with protecting domain names are overcome. A method and system protecting domain names is presented.

[0021] One aspect of the invention includes a method for issuing a permanent registration certificate for providing a permanent registration of a domain name. The permanent registration certificate provides a permanent registration of a domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar.

[0022] Another aspect of the invention includes a method for providing permanent registration of domain names using the permanent registration certificate.

[0023] Another aspect of the invention includes a method for perpetually hosting a web-site accessible via the Internet and associated with a domain name registration from an issued permanent registration certificate.

[0024] Another aspect of the invention includes a method for providing co-use of a domain name for which a permanent registration certificate has been issued.

[0025] The method and system described herein may help prevent a domain name owner from ever losing valuable domain name rights, reduce the burden and administrative overhead placed on domain name owners and more fully utilize existing and new rights associated with a domain name registration.

[0026] The foregoing and other features and advantages of embodiments of the present invention will be more readily apparent from the following detailed description. The detail description proceeds with references to accompanying drawings.

BRIEF DESCRIPTION OF THE DRAWINGS

[0027] Embodiments of the present invention are described with reference to the following drawings, wherein:

[0028] **FIG. 1** is a block diagram illustrating an exemplary domain name protection system;

[0029] **FIG. 2** is a flow diagram illustrating a method for protecting domain name registrations with a permanent registration certificate;

[0030] **FIGS. 3A and 3B** are a flow diagram illustrating a method for providing permanent registration of domain name registrations;

[0031] **FIG. 4** is a block diagram illustrating an exemplary data flow associated with the method of **FIG. 3**;

[0032] **FIG. 5** is a flow diagram illustrating a method for providing a permanent web-site; and

[0033] **FIG. 6** is a flow diagram illustrating a method for providing a co-use of a permanent domain name.

DETAILED DESCRIPTION OF THE PRESENT INVENTION

[0034] Exemplary Domain Name Protection System

[0035] **FIG. 1** is a block diagram illustrating an exemplary domain name protection system **10**. The exemplary domain name system **10** includes one or more client network devices **12, 14, 16** (only three of which are illustrated). The client network devices **12, 14, 16** include, but are not limited to, personal computers, wireless devices, mobile phones, personal information devices, personal digital assistants, handheld devices, network appliances, pagers, and other types of electronic devices. However, the present invention is not limited to these devices and more or fewer types of client electronic devices can also be used. The client network devices **12, 14, 16** are in communications with a computer network **18** (e.g., the Internet, intranet, etc.). The communication includes, but is not limited to, communications over a wire connected to the client network devices, wireless communications, and other types of communications.

[0036] Plural server network devices **20, 22, 24** (only three of which are illustrated) are associated with one or more associated databases are components of a permanent domain name registration system **26**. The permanent domain name registration system **26** includes a Purchase/Payment server **20**, an Administrative server **22** and a Web-site hosting server **24**. The plural network devices **20, 22** and **24** provide system for allowing a "permanent registration" of a domain name. However, more or fewer server network devices can also be used and the present invention is not limited to the illustrated components.

[0037] In addition, the plural server network devices are illustrated as separate network devices and the functionality of the server network devices can be split into additional servers, or combined into fewer servers. The plural server network devices **20, 22, 24** may also include duplicate or "mirrored" server network devices with associated plural databases to provide fault tolerance.

[0038] In another embodiment of the present invention, the plural server network devices **20, 22, 24** can also be combined into one server network device with associated plural databases. In such an embodiment, the single server network device and associated plural databases would include the necessary functionality to protect registered domain names and may include a duplicate or "mirrored" server network device with associated plural databases to provide fault tolerance.

[0039] The Purchase/Payment server **20** accepts domain name registration information and handles payment of current and future renewal fees for a domain name. The administrative server **22** helps ensures that the payment has been received by the public domain name registrar by checking for the updated next payment date, verifying payments, determining and solving payment and information discrepancies, etc. The Web-site hosting server **24** allows a domain name for which a permanent registration has been obtained to have a permanent presence on the computer network **18**. Thus, the Web-site hosting server **24** can "permanently" host a web-site.

[0040] An operating environment for components of the domain name protection system **10** for preferred embodiments of the present invention include a processing system with at least one high speed Central Processing Unit ("CPU") and memory. In accordance with the practices of persons skilled in the art of computer programming, the present invention is described below with reference to acts and symbolic representations of operations or instructions that are performed by the processing system, unless indicated otherwise. Such acts and operations or instructions are referred to as being "computer-executed,""CPU-executed," or "processor-executed."

[0041] It will be appreciated that acts and symbolically represented operations or instructions include the manipulation of electrical signals or biological signals by the CPU. An electrical system represents data bits which cause a resulting transformation or reduction of the electrical signals, and the maintenance of data bits at memory locations in a memory system to thereby reconfigure or otherwise alter the CPU's operation, as well as other processing of signals. The memory locations where data bits are maintained are physical locations that have particular electrical, magnetic, optical, or organic properties corresponding to the data bits.

[0042] The data bits may also be maintained on a computer readable medium including magnetic disks, optical disks, organic memory, and any other volatile (e.g., Random Access Memory ("RAM")) or non-volatile (e.g., Read-Only Memory ("ROM")) mass storage system readable by the CPU. The computer readable medium includes cooperating or interconnected computer readable medium, which exist exclusively on the processing system or be distributed among multiple interconnected processing systems that may be local or remote to the processing system.

[0043] Protecting a Domain Name Registration

[0044] **FIG. 2** is a flow diagram illustrating a Method **30** for protecting domain name registrations with a permanent registration certificate. At Step **32**, information associated with a domain name registration obtained from a public domain name registrar is accepted on a permanent domain name registration system. At Step **34**, a one-time permanent registration fee for the domain name registration is accepted on the permanent domain name registration system. At Step **36**, a permanent registration certificate is issued for the domain name registration based on the accepted information. The permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying future renewal fees for the domain name registration at the public domain name registrar from the permanent domain name registration system.

[0045] Method **30** may also comprise any or all of the additional steps of: issuing a domain name registration title, issuing an insurance policy, issuing plural ownership shares, issuing leases or sub-leases, issuing co-ownership certificates, or creating new or additional rights in the domain name associated with the permanent registration certificate.

[0046] The domain name registration title ("Domain Title") covers financial losses associated with not properly renewing a domain name registration. The Domain Title can be used alone, or in combination with the insurance policy. In one embodiment of the present invention, the Domain Title is implemented as a contract. However, the present invention is not limited to such an embodiment, and other embodiments can also be used.

[0047] The insurance policy covers financial losses associated with not properly renewing a domain name registration. The insurance policy provides compensation for any financial losses associated with accidental disruption or loss of domain name rights use. The insurance policy also allows trustees and/or beneficiaries for permanent domain name registrations to be named to ensure that the wishes of domain name registration holder are honored, regardless of situations resulting from inaction, disability or death.

[0048] The plural ownership shares allow ownership interests to be sold in the permanent domain name registration. In one embodiment of the present invention, the plural shares are implemented as contracts designed to support the specific features of equity sharing, co-ownership or "stock" ownership in domain names. However, the present invention is not limited to such an embodiment, and other embodiments can also be used.

[0049] Multiple share owners with defined shared rights could co-exist in a similar way. For example, in the world of real estate, condominium or apartment owners share clearly

defined ownership rights with other owners within a larger property which in itself is a separate legal entity. The holder of shares can sell shares in a domain name to investors for income or appreciation or to make many types of ownership and sharing of domain names possible in ways that are not currently viable.

[0050] Issuing leases or sub-leases for a domain name associated with the permanent registration certificate allows ownership interests to be reserved for a limited duration in a domain name registration associated with the permanent registration certificate. The holder of a Domain Title could lease the use of the domain name or portions of it to another entity for a period of any length, while providing rights including renewal rights and right of first refusal. Such a system of leasing could not be considered reliable under the current system because the current "right holder" could not guarantee their ability to confer those rights beyond the term of currently paid domain name registration fees.

[0051] Issuing co-ownership certificates for the domain name associated with the permanent registration certificate allows two or more entities in two or more different locations to co-own one domain name registration associated with the permanent registration certificate. For example, two common law trademark owners located in different parts of the U.S. or in different parts of the world could co-own a domain name registration.

[0052] In one embodiment of the present invention, creating new or additional rights includes creating additional contract layers on top of the permanent domain name registration system **26**. This new contract layers may require a third-party to guarantee the new or additional rights associated with the permanent registration certificate can be enforced.

[0053] Method **30** is illustrated with an exemplary embodiment. However, the present invention is not limited to this exemplary embodiment and other embodiments can also be used with Method **30**.

[0054] At Step **32**, information associated with a domain name registration obtained from a public domain name registrar **28** such as NSI, or other ICAAN approved registrar is accepted on the permanent domain name registration system **26**. In another embodiment of the present invention, the information can also be accepted from a private domain name registrar (e.g., a private domain name registrar for an intranet or other private computer network). In another embodiment of the present invention, the permanent domain name registration system **26** could also accept information from a user and issue its own domain name registration for either a public or a private network **18**. In another embodiment of the present invention, the permanent domain name registration system **26** could also obtain a domain name registration from a public domain name registrar for a user.

[0055] In one embodiment of the present invention, the accepted information includes the domain name, domain name owner, address, domain name server information and other information. However, more or fewer types of information can be accepted and the present invention is not limited to this list.

[0056] In one embodiment of the present invention, at Step **32** a user enters required information regarding a registered domain name that is accepted into the Purchase/Payment server **20**. In another embodiment of the present invention, the Purchase/Payment server **20** accepts required information directly from the public domain name registrar **28**.

[0057] In one embodiment of the present invention, the Purchase/Payment server **20** dynamically checks the information with the appropriate public domain name registrar after it has been accepted. The information is checked to determine if the information is accurate, has not been tampered with, or has not been altered without explicit notification or permission of either the original domain name registrant and/or the public domain name registrar **28**. This provides an additional security measure for the permanent domain name registration system **26**.

[0058] At Step **34**, a one-time permanent registration fee for the domain name registration is accepted on the permanent domain name registration system **26**. In one embodiment of the present invention, Step **34** includes accepting a one-time permanent registration fee electronically over the Internet **18** on Purchase/Payment server **20**. The fee is accepted electronically by accepting credit-card information, debit-card information, checking account information, electronic funds transfer information, or other types of electronic payment or e-commerce payment information.

[0059] In another embodiment of the present invention, the fee can be accepted by administrative or support personal via telephone by collecting appropriate credit or debit information from a user. In another embodiment of the present invention, the fee can be accepted via check, money order, etc. sent via the U.S. mail, express mail, etc. In embodiments where the one-time permanent registration fee is not accepted electronically, the permanent registration certificate described below is not issued until the fee payment has been verified (e.g., waiting for a check to clear, etc.).

[0060] In one embodiment of the present invention, the one-time permanent registration fee is added to financial instruments whose profits or interest is used to perpetually pay future renewal fees for the domain name registration. For example, the financial instrument can include an interest bearing account, a certificate of deposit, mutual funds, stocks, bonds, annuities, or other type of financial instrument.

[0061] In one embodiment, the one-time permanent registration fee is selected such that a first portion of the fee will be used to satisfy current registration fees and administrative costs at the public domain name registrar **28**. A second portion of the fee is enough to generate interest or other income through investments and/or the sale of additional goods or services to pay all current and future administrative costs and future registration fees in perpetuity for the domain name registration on the permanent domain name registration system **26**. One skilled in the art can determine that the one-time permanent registration fee can be divided into various other portions that are distributed in various ways to cover costs and fees on the permanent domain name registration system **26** and the public domain name registrar **28**.

[0062] In one embodiment of the present invention, the one-time permanent registration fee is selected based on contractual or other agreements with one or more public

domain name registrars. For example, a first user may have obtained a domain name registration from a first public domain name registrar that has a contractual agreement with the permanent domain name registration system **26** owners. The first public domain name registrar may have agreed to allow renewal of a domain name registrar perpetually for $10 per year. The one-time permanent registration fee would then be selected based on the $10 per year renewal fee. If a second public domain name registrar agreed to allow renewal of domain names it registered for $8 per year, a different one-time permanent registration fee could be selected. Various types of contractual or other legal agreements between public domain name registrars and the permanent domain name registration system **26** allow the one-time permanent registration fee to be variable and flexible.

[0063] The accepted information is stored in one or more databases **20'**, **22'** and/or **24'** associated with the permanent domain name registration system **26**. Table 1 illustrates exemplary information accepted and stored for a domain name registration. However, the accepted and stored information is exemplary only and more or less information can also be stored.

TABLE 1

Permanent Registration Certificate Number: 13579246
Insurance Policy Number: xxx
Domain Title Number: xxx
Domain Share Certificate Number xxx
Payment Account Number: xxx
Lease/Sublease Number: xxx
Co-User Number: xxx
Co-Owner Number: xxx
Contract Number: xxx
Registrar(s): xxx
US Domain Name: permanentweb.com
Administrative Contact: Chuck Brown
Hamlin Computer Technology, Inc.
5100 Hamlin Avenue
Chicago, Illinois 60625 US Phone- 773-463-2051 Fax-
Technical Contact: Thomas Brown
Global Logistics Corp Domain Management Division
Port Vila, 1 VU
Phone- +64 21-360-006
Fax- +1-801-749-2901
Record u dated on 2000-08-24 00:00:00.
Record created on 2000-08-24.
Record expires on 2001-08-24.
Database last updated on 2001-05-31 1013:36 EST.
Domain servers in listed order:
NS.BULKREGISTER.COM 216.147.43.234
NS2.BULKREGISTER.COM 216.147.1.164

[0064] At Step **36**, a permanent registration certificate is issued for the domain name registration. The permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying future renewal fees for the domain name registration at the public domain name registrar **28** from the permanent domain name registration system **26**.

[0065] In one embodiment of the present invention, an electronic permanent registration certificate is created from the accepted information and forwarded to the domain name owner electronically. The electronic permanent registration certificate is stored on one or more databases **20'**, **22'**, **24'** associated with the permanent domain name registration system **26**. The electronic permanent registration certificate can be viewed via computer network **18** (e.g., with a web-browser). Access to the electronic permanent registration certificate may be limited to the domain name owner(s) and protected by one or more security measures (e.g., login, password, encryption, etc.).

[0066] In another embodiment of the present invention, a paper permanent registration certificate is issued at Step **38**. The accepted information used to create the paper permanent registration certificate is stored on one or more databases **20'**, **22'**, **24'** associated with the permanent domain name registration system. The paper permanent registration certificate is then forwarded to the domain name owner for safekeeping. However, the present invention is not limited to such embodiments and the present invention can be used with other types of permanent registration certificates.

[0067] Method **30** enables domain name owners to establish permanent rights to a domain name registration and provide a process to help reduce the risk that a domain name registration will lapse because of error or inaction, or other unforeseen circumstances.

[0068] Providing Permanent Registration of Domain Names

[0069] **FIGS. 3A and 3B** are a flow diagram illustrating a Method **40** for providing permanent registration of a domain name registrations. In **FIG. 3A** at Step **42**, a list of domain name registrations is generated from one or more databases associated with a permanent domain name registration system for which renewal fees on a public domain name registrar must be paid. The generated list of domain name registrations includes plural domain name registrations for which plural permanent registration certificates have been purchased. The permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees for the domain name registration at the public domain name registrar from the permanent domain name registration system. At Step **44**, renewals fees are paid electronically on the public domain name registrar for the list of generated domain name registrations. At Step **46**, a query is conducted at the public domain register to determine whether all of the domain name registrations from the generated list of domain name registration have been renewed on the public domain name registrar.

[0070] If all of the domain name registration have not been renewed on the public domain registrar, then in **FIG. 3B** at Step **48**, additional renewal fees are transferred for any domain name registrations that have not been renewed on the public domain name registrar, thereby ensuring renewal of domain name registrations. At Step **50**, administrators at the permanent domain name registration system and the public domain name registrar are notified of any renewal fee discrepancies. Steps **42-46** are repeated periodically and perpetually to ensure that all domain name registrations on the permanent domain name registration system are properly renewed.

[0071] If all of the domain name registration have been renewed on the public domain registrar at Step **46**, then Steps **42-46** are repeated periodically and perpetually to ensure that all domain name registrations on the permanent domain name registration system are properly renewed.

[0072] Method **40** is illustrated with an exemplary embodiment. However, the present invention is not limited to this exemplary embodiment and other embodiments can also be used with Method **40**.

[0073] At Step **42**, a list of domain name registrations is periodically generated from one or more databases **20'22'24'** associated with a permanent domain name registration system **26** for which renewal fees on a public domain name registrar **28** must be paid.

[0074] The permanent domain name registration system **26** maintains lists of domain name registrations and ensures that payments are transferred to an appropriate public domain name registrar **28** in advance of the due date without fail. The permanent domain name registration system **26** is based on redundant databases with checks and balances and automatic pre-payment and verification of registration fees. The permanent domain name registration system helps reduce or even eliminate any possibility of an accidental domain name registration deletion or non-payment. The permanent domain name registration system **26** also helps satisfy requirements of an insurance company that may be issuing business interruption insurance associated with the permanent registration certificate.

[0075] In one embodiment of the present invention, the permanent domain name registration system **26** cross-checks domain name registration information from three databases **20'**, **22'** and **28'** and generates the list at Step **42**. One database is a Purchase/Payment Database **20'**. Another database is an Administration Database **22'**. These two databases **20'** and **22'** are maintained by the permanent domain name registration system **26**. The third database **28'** is a database maintained by public domain name registrar **28** that issues the actual domain name registrations. The third database **28** may be multiple databases for one public domain name registrar, or multiple databases for multiple public domain name registrars. The third database **28'** may also include one or more database for a private domain name registrar.

[0076] In one embodiment of the present invention, the Purchase/Payment and Administration databases **20'**, **22'** will have separate administrators and controls to ensure that an error on the part of one server, database or person will not result in a lost domain name registration or a missed payment. Automatic messages will be sent to the administrators of all three databases in the case of any discrepancies between the databases. These messages will be repeated until the problem has been resolved. The destinations, frequency and escalation procedures for those messages are configurable.

[0077] In one embodiment of the present invention, the Purchase/Payment database **20'** maintains a full list of covered domain name registration and renewal dates and is responsible for generating payment lists at Step **42** for upcoming months and for receiving the renewal notifications from the public domain name registrar **28**. However, the present invention is not limited to this embodiment and other components of the permanent domain name registration system **26** can generate lists at Step **42**.

[0078] In one embodiment of the present invention, the Purchase/Payment server **20** generates list of renewals due in the next month from the Purchase/Payment database **20'** For example, renewals due in May will be generated by the first day of April.

[0079] The Administrative database **22'** also includes a list of all covered domain name registration with the information included in the Purchase/Payment database **20'**. In addition, this database includes full client account information including login security information and account history.

[0080] The third database **28'** is an existing external database maintained by the public domain name registrar **28**. The data it maintains is includes information returned by a "whois" check on a domain name. As is known in the art, whois is an Internet-based directory service for looking up names of owners of domain name registrations.

[0081] Returning to **FIG. 3A** at Step **44**, renewals fees are paid electronically on the public domain name registrar for the list of generated domain name registrations. In another embodiment of the present invention, renewal fees can be paid by other methods as was described above for accepting payment for a permanent registration certificate (e.g., via the telephone, via the U.S. mail, etc.). The present invention is not limited to paying renewal fees electronically.

[0082] The renewal fees paid at Step **44** can be paid in a number of different manners based on a number of different factors. In one embodiment, the renewal fees are paid electronically only for domain name registrations that will expire in the next month. In another embodiment of the present invention, the renewal fees are paid electronically for all domain name registration that will expire in a pre-determined time period (e.g., 3 months). In another embodiment of the present invention, the additional renewal fees are also paid electronically when a value of a renewal fee account at the public domain name registrar falls below a pre-determined amount.

[0083] The payment system may also include an advanced payment balance or buffer at each public domain name registrar **28** or selected public domain name registrars. The purpose of the advanced buffer is to ensure that the enough money will be on hand for the registrar to draw down from as the covered domains come due. The buffer will provide an additional level of assurance that in the case of a missed payment by the

[0084] Administrative server **22** and/or Purchase/Payment server **20**, and/or the public domain name registrar **28** will still be able to draw the required payment from the excess funds in the payment buffer. When the payment system checks the balance of the payment buffer and finds a discrepancy, the database administrators will be notified and required to find the reason for the missed payment or missed domain name and make the corrections and balance the account.

[0085] At Step **46**, a query is conducted at the public domain register **28** to determine whether all of the domain name registrations from the generated list of domain name registrations have been renewed on the public domain name registrar **28**.

[0086] In one embodiment of the present invention, the Administrative server **22** conducts the query at Step **46**. However, the present invention is not limited to such an embodiment and the query conducted at Step **46** can be conducted from other components of the permanent domain name registration system **26**.

[0087] In one embodiment of the present invention, the query at Step **46** is conducted on databases on the permanent domain name registration system **26** and on the public domain name registrar **28**. In such an embodiment, the results are compared to immediately determine an inconsistencies and the appropriate database administrators are notified.

[0088] If there are any domain names from the list that have not be marked as renewed by the public domain name registrar **28**, the Administrative server **22** flags any such domain names. The Administrative server **22** sends a message to the Purchase/Payment database **20'** to transfer the additional funds to the public domain name registrar **28**.

[0089] At Step **48** of **FIG. 3B**, additional renewal fees are transferred by the Purchase/Payment server **20** for any domain name registrations that have not been renewed on the public domain name registrar **28**, thereby ensuring renewal of domain name registrations. At Step **50**, the Administrative server **22** notifies administrators at the permanent domain name registration system **26** and the public domain name registrar **28** of any renewal fee discrepancies.

[0090] If the query at Step **46** shows that all of the domain name registrations from the generated list of domain name registrations have been renewed on the public domain name registrar **28**, then processing continues periodically at Step **42** of **FIG. 3A**.

[0091] If the Administrative database **22'** includes any domain name registrations that it shows as expiring in the following month for which the public domain name registrar **28** does not show a renewal fee is due, the Administrative server **22** sends a message to the Purchase/Payment database **20'** to transfer the additional funds. Additionally, administrators for both databases are notified of the discrepancy.

[0092] In one embodiment of the present invention, at the end of each month, the Purchase/Payment server **20** optionally checks the balance in the public domain name registrar account **54** to verify that an expected balance is present. However, the present invention is not limited to this embodiment. In the case of an unexpected balance, both administrators are notified.

[0093] Steps **42-46 (FIG. 3A)** are repeated on a periodic basis. For example, weekly a series of automated checks will be run to verify that the public domain name registrar database **28'**, the Purchase/Payment database **20'** and the Administrative database **22'** are all in agreement with respect to domain name registrations and renewal dates. If any discrepancies are found, the respective administrators are notified. However, the present invention, is not limited to a weekly series of automated checks and virtually any larger or smaller time period could be used to repeat Steps **42-46** (e.g, minutes, hours, days, etc.).

[0094] The integrity of the permanent domain name registration system **26** is also monitored frequently. Public domain name registrar databases **28'** are also monitored frequently to determine any changes made by a domain name owner. Any determined changes are propagated to, or corrected in databases **20', 22', 24'** in the permanent domain name registration system **26** and/or public domain name registrar database **28'**. Public domain name registrar databases **28'** and databases **20', 22', 24'** are also monitored frequently to determine if any improper changes have been made by hackers or hijackers.

[0095] Exemplary Data Flow for Providing Permanent Registration of Domain Names

[0096] **FIG. 4** is a block diagram illustrating an exemplary data flow **54** associated with Method **40** of **FIG. 3**. In **FIG. 3A** at Step **42**, a list of domain name registrations **56** is generated by the Purchase/Payment Server **20** from one or more databases **20', 22'** and **24'** associated with a permanent domain name registration system **26** for which renewal fees on a public domain name registrar **28** must be paid. This is illustrated by Line **58**.

[0097] At Step **44**, renewals fees are paid electronically to an account **60** for the public domain name registrar **28** for the list of generated domain name registrations **56**. This is illustrated by Line **62**.

[0098] At Step **46**, a query is conducted from the Administrative Server **28** at the public domain register **28** to determine whether all of the domain name registrations from the generated list of domain name registrations **56** have been renewed on the public domain name registrar **28**. This is illustrated by Line **64**.

[0099] If there are any domain names from the list that have not be marked as renewed by the public domain name registrar **28**, the Administrative server **22** flags any such domain names. The Administrative server **22** sends a message to the Purchase/Payment server **20** to transfer the additional funds to the public domain name registrar **28**. This is illustrated by Line **66**.

[0100] At Step **48** of **FIG. 3B**, additional renewal fees are transferred by the Purchase/Payment server **20** for any domain name registrations that have not been renewed on the public domain name registrar **28**, thereby ensuring renewal of domain name registrations. This is illustrated by Line **68**. At Step **50**, the Administrative server **22** notifies the Purchase/Payment Server **22** at the permanent domain name registration system **26** and the public domain name registrar server **28** of any renewal fee discrepancies. This is illustrated by lines **70** and **70'**.

[0101] Providing a Permanent Web-Site for Permanently Registered Domain Names

[0102] **FIG. 5** is a flow diagram illustrating a Method **74** for providing a permanent web-site. At Step **76**, a domain name for which a permanent registration certificate has been issued is accepted on a permanent domain name registration system. The permanent registration certificate provides a permanent registration of the domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar from the permanent domain name registration system. At Step **78**, electronic content for a web-site to be associated with the domain name is accepted. At Step **80**, a one-time permanent web-site fee for hosting the domain name on the permanent domain name registration system is accepted. The one-time permanent web-site fee is used to perpetually host the domain name on the permanent domain name registration system. At Step **82**, a web-site accessible via the Internet associated with the domain name is perpetually hosted on the permanent domain name system.

[0103] Method **74** is illustrated with an exemplary embodiment. However, the present invention is not limited to this exemplary embodiment and other embodiments can also be used with Method **74**.

[0104] At Step **76**, a domain name for which a permanent registration certificate has been issued is accepted on the permanent domain name registration system **26**. The permanent registration certificate provides a permanent registration of the domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar from the permanent domain name registration system. For example, a permanent registration certificate issued via Method **30** (FIG. 2).

[0105] At Step **78**, electronic content for a permanent web-site to be associated with the domain name is accepted on the permanent domain name registration system **26**. In one embodiment of the present invention, the electronic content is accepted via permanent web-site server **24** and stored in one or more permanent web-site databases **24'**. The electronic content accepted includes text, graphics, audio, video, and other electronic content.

[0106] At Step **80**, a one-time permanent web-site fee for hosting the domain name on the permanent domain name registration system **26** is accepted via the Purchase/Payment database **20'**. The payment is recorded on the Administrative database **22'**. The one-time permanent web-site fee is used to perpetually host the domain name on the permanent domain name registration system **26**.

[0107] As is known in the art, hosting a web-site includes providing hardware and software necessary to allow communications with the Internet and to service request/responses for electronic content on the web-site. In one embodiment of the present invention, the one-time permanent web-site fee is added to a financial instrument whose profits or interest is used to perpetually pay administrative costs to host a web-site for the domain name accessible via the Internet on the permanent domain name system. However, the present invention is not limited to such an embodiment.

[0108] At Step **82**, a permanent web-site accessible via the Internet **18** associated with the domain name is perpetually hosted on the permanent domain name system **26**. The perpetual hosting of the web-site helps provide a "permanent" presence on the Internet via a domain name by perpetually maintaining a web-site associated with the domain name and perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar from the permanent domain name registration system using a permanent registration certificate issued for the domain name.

[0109] In one embodiment the permanent web-site is hosted directly by the permanent web-site server **24** on the permanent domain name registration system **26**.

[0110] In another embodiment of the present invention, the "permanent web-site" is not hosted from the permanent domain name registration system **26**. In such an embodiment the permanent web-site is hosted by another host. However, the permanent domain name registration system **26** continually monitors the host to ensure the host is viable and has is not having problems or has gone out of business.

[0111] In another embodiment of the present invention, the permanent web-site server **24** hosts the domain name associated with the permanent web-site (e.g., by accepting queries to a published IP address), but maps or otherwise re-directs any queries from the computer network **18** to an appropriate host that is actually hosting the permanent web-site.

[0112] The permanent web-site server **24** also frequently monitors the host to update any new content stored on the permanent web-site. In one embodiment of the present invention, any new content added to the permanent web-site must be sent to the permanent web-site server **24** by the permanent web-site. In another embodiment of the present invention, the permanent web-site server **24** automatically monitors the permanent web-site and automatically downloads and stores any new content in the permanent web-site database **24'** to keep the permanent web-site database up-to-date. If the host is having problems or has gone out of business, the permanent web-site is then immediately hosted via permanent web-site server **24**.

[0113] If a host is having problems or has gone out of business, the IP address identifying the domain name for the permanent web-site at the host can be immediately re-mapped to a new IP address on the permanent web-site server **24**. Thus, the permanent web-site can be permanently hosted by the permanent domain name registration system **26** in a variety of different ways.

[0114] Co-Using a Permanent Domain Name

[0115] **FIG. 6** is a flow diagram illustrating a Method **86** for providing a co-use of a permanent domain name. At Step **88**, a permanent domain name is hosted on a network server. The permanent domain name is a domain name for which a permanent registration certificate has been issued. The permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at a public domain name registrar from a permanent domain name registration system. The permanent domain name is co-used by plural co-users. At Step **90**, a request for electronic content is accepted on the network server for one of the plural co-users using the permanent domain name. At Step **92**, a determination is made to determine which one of the plural co-users the request is for using information included in headers used with a protocol used to request the electronic content. At Step **94**, the request is directed to the determined co-user.

[0116] The plural co-users can be co-owners of the permanent domain name. The plural co-users can also be leasing or sub-leasing the permanent domain name for one or more permanent domain name owners. Co-ownership and leasing/sub-leasing of a permanent domain name was discussed above.

[0117] Method **86** is illustrated with an exemplary embodiment. However, the present invention is not limited to this exemplary embodiment and other embodiments can also be used with Method **86**.

[0118] In such an embodiment at Step **88**, a permanent domain name is hosted on the Web-site hosting server **24**. The permanent domain name is a domain name for which a permanent domain name registration certificate has been

issued (e.g., with Method **30** of **FIG. 2**). The permanent domain name is co-used by plural co-users. At Step **90**, a request for electronic content is accepted on the Web-site hosting server **24** for one of the plural co-users using the permanent domain name. At Step **92**, a determination is made to determine which one of the plural co-users the request for electronic content is for using information included in headers used with a protocol used to request the electronic content. In one embodiment of the present invention, the determination made at Step **92** includes making a determination using an IP address in a header for a protocol used to request the electronic content. However, the present invention is not limited to such an embodiment and other determinations can also be used at Step **92**.

[0119] In one embodiment of the present invention, the protocol used the electronic content can include, but is not limited to, the Hyper Text Transfer Protocol ("HTTP"), File Transfer Protocol ("FTP"), Simple Mail Transfer Protocol ("SMTP"), a variety of other protocols from the Internet Protocol suite, or other types of networking protocols.

[0120] In one embodiment of the present invention, the Web-site hosting server **24** maintains tables for co-users of a permanent domain name. The tables include specific IP addresses or ranges of IP addresses for which a co-user of a permanent domain name will accept requests for electronic content. These tables allow two or more co-users to co-use the same permanent domain name from different geographic regions, or based on other pre-determined criteria (e.g., cooperative agreements, contracts, advertising or other fees, etc.). At Step **94**, the request is directed to the determined co-user by the Web-site hosting server **24**.

[0121] In one embodiment of the present invention, Method **86** helps allow co-use of a permanent domain name, thus helping to reduce trademark disputes or other business disputes. Business disputes can also be resolved with Method **86** by a neutral third-party outside the permanent domain name owners, the permanent domain name registration system **26** or the public domain name registrar **28**.

[0122] As an example, to reduce trademark disputes, suppose a first co-user was using a permanent domain name in based on a common law trademark in Illinois and a second co-user was using the same permanent domain name in California. The Web-site hosting server **24** could then use pre-determined IP addresses or ranges of IP addresses to determine whether a request is for the first or second co-user. The IP addresses are used to determine a geographic region the request came from, and then direct the request to the co-user that in the geographic region closest to the requester. Conflicts are resolved with a pre-determined set of rules or sending the information to a default co-user.

[0123] The methods and system described herein overcome many of the problems associated with domain names described above. The method and system help to permanently protect and utilize domain name registrations. The method and system help prevent a domain name owner from ever losing valuable domain name rights, reduce the burden and administrative overhead placed on domain name owners and more fully utilize existing and new rights associated with a domain name registration.

[0124] It should be understood that the programs, processes, methods and system described herein are not related or limited to any particular type of computer or network system (hardware or software), unless indicated otherwise. Various types of general purpose or specialized computer systems may be used with or perform operations in accordance with the teachings described herein.

[0125] In view of the wide variety of embodiments to which the principles of the present invention can be applied, it should be understood that the illustrated embodiments are exemplary only, and should not be taken as limiting the scope of the present invention. For example, the steps of the flow diagrams may be taken in sequences other than those described, and more or fewer elements may be used in the block diagrams.

[0126] While various elements of the preferred embodiments have been described as being implemented in software, in other embodiments including hardware or firmware implementations, or combinations thereof, may alternatively be used, and visa versa.

[0127] The claims should not be read as limited to the described order or elements unless stated to that effect. In addition, use of the term "means" in any claim is intended to invoke 35 U.S.C. §112, paragraph 6, and any claim without the word "means" is not so intended. Therefore, all embodiments that come within the scope and spirit of the following claims and equivalents thereto are claimed as the invention.

I claim:

1. A method for protecting domain name registrations with a permanent registration certificate, comprising:

accepting information associated with a domain name registration obtained from a public domain name registrar on a permanent domain name registration system;

accepting a one-time permanent registration fee for the domain name registration on the permanent domain name registration system, wherein the one-time permanent registration fee is used to perpetually pay all future renewal fees for the domain name registration; and

issuing a permanent registration certificate for the domain name registration based on the accepted information, wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at the public domain name registrar from the permanent domain name registration system.

2. The method of claim 1 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method.

3. The method of claim 1 further comprising:

creating an electronic permanent registration certificate from the accepted information; and

storing an electronic permanent registration certificate in one or more databases associated with the permanent domain name registration system, wherein the stored electronic permanent registration certificate can be viewed via a computer network.

4. The method of claim 1 further comprising:

issuing a domain name registration insurance policy with the permanent registration certificate, wherein the insurance policy covers financial losses associated with not properly renewing a domain name registration.

5. The method of claim 1 further comprising:

issuing a domain name registration title with the permanent registration certificate, wherein the domain name registration title covers financial losses associated with not properly renewing a domain name registration.

6. The method of claim 1 further comprising:

issuing a plurality shares in the domain name associated with the permanent registration certificate, wherein, the plurality of shares allow a plurality of ownership interests to be sold in the domain name registration associated with the permanent registration certificate.

7. The method of claim 1 further comprising:

issuing leases or sub-leases for the domain name associated with the permanent registration certificate, wherein, the leases or sub-leases allow ownership interests to be reserved for a limited duration in the domain name registration associated with the permanent registration certificate.

8. The method of claim 1 further comprising:

issuing co-ownership certificates for the domain name associated with the permanent registration certificate, wherein, co-ownership certificates allow two or more entities in two or more different locations to co-own one domain name registration associated with the permanent registration certificate.

9. The method of claim 1 wherein the step of issuing a permanent registration certificate includes issuing an electronic permanent registration certificate or other than an electronic permanent registration certificate.

10. The method of claim 1 wherein the one-time permanent registration fee is added to a financial instrument whose profits or interest is used to perpetually pay future renewal fees for the domain name registration.

11. The method of claim 10 wherein the financial instrument includes an interest bearing account, a certificate of deposit, mutual funds, stocks, bonds or annuities.

12. The method of claim 1 wherein the step of accepting a one-time permanent registration fee includes accepting a one-time permanent registration fee electronically over the Internet.

13. The method of claim 1 wherein the step of accepting a one-time permanent registration fee includes accepting a one-time permanent registration fee other than electronically over the Internet.

14. A method for providing permanent registration of domain names, comprising:

(a) generating a list of domain name registrations from one or more databases associated with a permanent domain name registration system for which renewal fees on a public domain name registrar must be paid,

wherein the generated list of domain name registrations includes a plurality of domain name registrations for which a plurality of permanent registration certificate has been purchased,

wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees for the domain name registration at the public domain name registrar from the permanent domain name registration system;

(b) paying renewals fees electronically on the public domain name registrar for the list of generated domain name registrations;

(c) querying the public domain register to determine whether all of the domain name registrations from the generated list of domain name registrations have been renewed on the public domain name registrar, and if not,

(d) transferring additional renewal fees for any domain name registrations from the generated first list of domain name registrations that have not been renewed on the public domain name registrar, thereby ensuring renewal of domain name registrations, and

(e) notifying administrators at the permanent domain name registration system and the public domain name registrar of any renewal fee discrepancies; and

(f) repeating steps (a)-(c) periodically.

15. The method of claim 14 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method.

16. The method of claim 14 wherein the step of generating a list of domain name registrations includes generating a list of domain name registrations a pre-determined time period before renewal fees on a public domain name registrar must be paid.

17. The method of claim 14 further comprising:

periodically comparing renewal dates for the plurality of domain name registrations on the permanent domain name registration system with the renewal dates on the public domain name registrar; and

notifying administrators at the permanent domain name registration system and the public domain name registrar of any renewal date discrepancies.

18. The method of claim 14 further comprising:

periodically comparing renewal dates for the plurality of domain name registrations on the permanent domain name registration system with the renewal dates on the public domain name registrar;

determining from the permanent domain name registration system whether any renewal fees are due for any domain name registrations for which the public domain name registrar does not show a renewal fee is due, and if so,

transferring additional renewal fees for any such domain name registrations, and

notifying administrators at the permanent domain name registration system and the public domain name registrar of any renewal date discrepancies.

19. A method for providing a permanent web-site, comprising:

accepting a domain name for which a permanent registration certificate has been issued, wherein the perma-

nent registration certificate provides a permanent registration of the domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar from a permanent domain name registration system;

accepting electronic content for a permanent web-site to be associated with the domain name on the permanent domain name registration system;

accepting a one-time permanent web-site fee for hosting the domain name on the permanent domain name registration system, wherein the one-time permanent web-site fee is used to perpetually host the domain name on the permanent domain name registration system; and

perpetually hosting a permanent web-site accessible via the Internet for the domain name for which a permanent registration certificate has been issued.

20. The method of claim 19 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method.

21. The method of claim 19 wherein the one-time permanent web-site fee is added to a financial instrument whose profits or interest is used to perpetually pay administrative costs to host a web-site for the domain name accessible via the Internet on the permanent domain name system.

22. The method of claim 21 wherein the financial instrument includes an interest bearing account, a certificate of deposit, mutual funds, stocks, bonds or annuities.

23. The method of claim 19 wherein the step of perpetually hosting a web-site includes perpetually hosting the web-site on the permanent domain name registration system.

24. The method of claim 19 wherein the step of perpetually hosting a web-site includes perpetually hosting the web-site on a host other than the permanent domain name registration system.

25. A method of providing co-use of a permanent registration of a domain name, comprising:

hosting a permanent domain name on a network server, wherein the permanent domain name is a domain name for which a permanent registration certificate has been issued, wherein the permanent registration certificate provides a permanent registration of the domain name registration including perpetually determining, paying and verifying current and future renewal fees due for the domain name registration at a public domain name registrar from a permanent domain name registration system and wherein the permanent domain name is co-used by a plurality of co-users;

accepting a request for electronic content on the network server for one of the plurality of co-users using the permanent domain name;

determining which one of the plurality of co-users the request is for using information included in headers used with a protocol used to request the electronic content; and

directing the request to the determined co-user.

26. The method of claim 25 further comprising a computer readable medium having stored therein instructions for causing a processor to execute the steps of the method.

27. The method of claim 25 wherein the plurality of co-users are co-owners of the permanent domain name.

28. The method of claim 25 wherein the plurality of co-users are leasing or sub-leasing the permanent domain name.

29. The method of claim 25 wherein the step determining which one of the plurality of co-users the request is for using information included in headers used with a protocol used to request the electronic content includes determining which one of the plurality of co-users the request is for using an Internet Protocol address included in a header used with a protocol used to request the electronic content.

30. A permanent domain name registration system, comprising in combination:

a permanent registration certificate for providing permanent registration of a domain name, wherein the permanent registration certificate provides a permanent registration of a domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar; and

a plurality of servers associated with a plurality of databases accessible via the Internet for accepting information associated with a domain name registration obtained at the public domain name registrar, accepting a one-time permanent registration fee for the permanent registration certificate and for issuing the permanent registration certificate.

31. The system of claim 30 wherein the plurality of servers associated with a plurality of databases include a Purchase/Payment server and associated database, an administrative server and associated database and a permanent web-site server and associated database.

32. A permanent domain name registration system, comprising in combination:

a permanent registration certificate for providing permanent registration of a domain name, wherein the permanent registration certificate provides a permanent registration of a domain name including perpetually determining, paying and verifying current and future renewal fees for the domain name at a public domain name registrar;

a permanent web-site for perpetually hosting a web-site associated with the domain name registration from an issued permanent registration certificate, wherein the web-site is accessible via the Internet; and

a plurality of servers associated with a plurality of databases accessible via the Internet for issuing a permanent registration certificate for a domain name registration, perpetually hosting a web-site associated with the domain name registration from an issued permanent registration certificate, wherein the web-site is accessible via the Internet, accepting a one-time permanent registration fee for the permanent registration certificate and accepting a one-time permanent web-site fee for perpetually hosting a web-site associated with the domain name registration from an issued permanent registration certificate.

33. The system of claim 32 wherein the plurality of servers associated with a plurality of databases include a Purchase/Payment server and associated database, an administrative server and associated database and a permanent web-site server and associated database.

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